Supreme Court, U.S.
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No.

IN THE

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ of Certiorari
To The U.S. Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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36 pp

QUESTIONS PRESENTED FOR REVIEW

1. Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?

2. Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999) ?

3. May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be expanded under the doctrine of equivalents?

PARTIES TO THE PROCEEDING

Petitioner: Senior Technologies, Inc.

Petitioner's Corporate Disclosure Statement:

> Senior Technologies, Inc. has no parent company and has issued no shares to the public.

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35 U.S.C. 112 ..... 2, 14, 15, 18

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The Petitioner, Senior Technologies, Inc., respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit, entered in this proceeding on March 12, 2001.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit for which review is sought, *Senior Technologies, Inc. v. R.F. Technologies, Inc.*, is an unpublished decision (decided March 12, 2001) and appears in Appendix A, pages 1-25. The judgment order of the Court of Appeals issued as a mandate on April 12, 2001, and appears in Appendix B, pages 26-27.

The published decision of the United States District Court for the District of Nebraska, *Senior Technologies, Inc. v. R.F. Technologies, Inc.*, is reported at 58 F.Supp.2d 1076 (D. Neb. 1999) and appears in Appendix C, pages 28-66.

The Denial of the Petition for Rehearing in *Senior Technologies, Inc. v. R.F. Technologies, Inc.* (not reported) entered April 5, 2001, appears in Appendix D, pages 67-68.

JURISDICTION

This case is a patent infringement case decided and entered by the United States Court of Appeals for the Federal Circuit on March 12, 2001, attached hereto in Appendix A. A timely filed petition for rehearing by the

appellant was denied April 5, 2001, which denial is attached hereto in Appendix D.

The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1) (1970). The pertinent portions of 28 U.S.C. 1254 are:

> "§1254. Courts of appeals; certiorari; certified questions
>
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;...."

STATUTES INVOLVED

Title 35 U.S.C. §112 (July 19, 1952, ch. 950, §1, 66 Stat. 798; July 24, 1965, Pub. L. 89-83, §9, 79 Stat. 261; Nov. 14, 1975, Pub. L. 94-131, §7, 89 Stat.691):

> "§112 Specification
>
> * * *
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Title 35 U.S.C. §271 (July 19, 1952, ch. 950, §1, 66 Stat. 811; Sept. 24, 1984, Pub. L. 98-417, §202, 98 Stat. 1603; Nov. 8, 1984, Pub. L. 98-622, §101, 98 Stat. 3383; Aug. 23, 1988, Pub. L. 100-418, §9003, 102 Stat. 1563-64; Nov. 16, 1988, Pub. L. 100-670, §201, 102 Stat. 3988-3989; Nov. 19, 1988, Pub. L. 100-703, §201, 102 Stat. 4676; Oct. 28, 1992, Pub. L. 102-560, §2, 106 Stat. 4230; Dec. 8, 1994, Pub. L. 103-465, §533, 108 Stat. 4988):

> "§ 271 Infringement of patent
>
> (a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent."

STATEMENT OF CASE

I. Summary

On July 26, 1999, The U.S. District Court of the District of Nebraska issued its findings of fact and conclusions of law and ordered that judgment be entered against the plaintiff, Senior Technologies, Inc., on plaintiff's infringement claims for the reason that the defendant, R.F. Technologies, Inc., has not infringed plaintiff's United States Patents 4,682,155 or 5,268,670 and that judgment be entered against the defendant and in favor of the plaintiff on defendant's counterclaims for the reasons that United States Patent 4,682,155 is not invalid under 35 U.S.C. § 102 and that the defendant

failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patent No. 4,682,155 and U.S. Patent 5,268,670 unenforceable. *Senior Tech., Inc. v. R.F. Tech.*, 58 F.Supp. 2d 1076 (D. Neb. 1999), see Appendix C.

The U.S. Court of Appeals for the Federal Circuit affirmed the District Court's judgment, but in doing so found clear error in its non-infringement holding, but then considered alternative grounds present in the record for affirming the District Court's conclusion of non-infringement, stating:

> "…. When the functions of the microprocessor are properly understood, and the claim is read on those functions, the presence of the microprocessor in the accused device provides no ground for noninfringement of the claims.
>
> We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us…."
>
> (Appendix A, page 10, beginning with line 2 of the first paragraph)

This petition is directed to the holdings by the U.S. Court of Appeals for the Federal Circuit: (1) that claim 1 should be construed to include a sensing-module housing, which is not literally recited in the claim (Appendix A, page 10, third and fourth paragraphs); (2) that the doctrine of equivalents cannot be applied under

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999), because claim 1 was amended to cure ambiguities (Appendix A, page 13, fourth paragraph); and (3) that any effort to expand claim 1 would eviscerate the construed limitation under *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Circ. 1996) (Appendix A, page 16, second paragraph).

II. The Action and Jurisdiction

This action was brought by the petitioner herein in the United States District Court for the District of Nebraska in July of 1997, for infringement of U.S. Patents 4,682,155 and 5,268,670. The defendant, R.F. Technologies, Inc., respondent herein, counterclaimed for a declaration of invalidity, noninfringement and unenforceability. The court entered judgment against the plaintiff and in favor of the defendant on plaintiff's infringement claim for the reason the defendant did not infringe plaintiff's United States Patent 4,682,155 or plaintiff's United States Patent 5,268,670. On defendant's counterclaims against the plaintiff, judgment was entered against the defendant and in favor of the plaintiff for the reasons that United States Patent 4,682,155 was not invalid under 35 U.S.C. 102 and R.F. Technologies failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patents 4,682,155 and 5,268,670 unenforceable. See *Senior Tech., Inc. v. R.F. Tech.*, 58 F.Supp. 2d 1076 (D. Neb. 1999) (Appendix C, pages 28-66).

Jurisdiction and venue of the Court of first instance was invoked under Sections 1338(a), 1400(b), and 2201 of Title 28 U.S.C. and Sections 271, 281, 283, 284 and 285 of Title 35 U.S.C.

The subjects in controversy were departure alert systems for providing an alarm when unauthorized persons, such as Alzheimer patients, passed through the doorway such as for example of a nursing home wearing a wrist transmitter.

III. Trial, Judgment, Findings of Fact and Conclusions of Law

On July 26, 1999, the District Court below entered its findings of fact and conclusions of law and a judgment order was entered on September 1, 1999, for the defendant, R.F. Technologies, Inc., on infringement, and for the plaintiff, Senior Technologies, Inc., on the counterclaim for invalidity. A copy of the reported case is in Appendix C, pages 28-66.

IV. Appeal to the U.S. Court of Appeals for the Federal Circuit

A Notice of Appeal was filed by Senior Technologies, Inc. on September 30, 1999, from the decision of noninfringement. A Notice of Cross-Appeal was filed by R.F. Technologies, Inc. on October 12, 1999, from the rulings on claim definiteness, invalidity, inequitable conduct, and attorney's fees. The case on appeal was argued on October 6, 2000, before the United States Court of Appeals for the Federal Circuit. It was decided on March 12, 2001. A petition for rehearing was sent to

the Court for filing on March 23, 2001. The petition for rehearing was denied on April 5, 2001.

V. Holding of U.S. Court of Appeals for the Federal Circuit

The Court of Appeals found clear error in the District Court's decision of noninfringement (Appendix A, page 9, lines 11-16), but applied alternative grounds supported by the record (Appendix A, page 10, second paragraph) for affirming the U.S. District Court for the District of Nebraska. In considering the alternative grounds for noninfringement of claim 1, the Court of Appeals construed: (1) claim 1 as being limited by a single sensing-module housing (a housing for the transmitter is recited in claim 1, but not a housing for the receiver or sensing module) having a receiving circuit in it (Appendix A, page 10, third paragraph, through page 13); (2) the sensing module as including the receiving circuit (Appendix A, page 10, third paragraph, through page 13); (3) that the sensing means must be in the single construed sensing-module housing (Appendix A, page 14); and (4) the doctrine of equivalents cannot be used to expand the claim under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Circ. 1999) and *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996). *Festo, supra* was applied on the ground that claim 1 was amended "such that the 'receiving circuit' would be specifically located 'in the sensing module'" (Appendix A, page 14), and *Athletic, supra* on the ground it would "eviscerate the construed limitation" (Appendix A, page 16).

VI. Claims Presented for Review

Claim 1 of U.S. Patent 4,682,155 (pages A000077-A000085 of the Joint Appendix before the Court of Appeals) is the only claim presented for review. Claim 1 is:

> "1. A security sensing system for monitoring the passage of persons through a door or like opening comprising:
>
> a transmitter module for installing on persons to be monitored, a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response, and alarm means energizable in response to the production of the output response to produce an alarm condition,
>
> the transmitter module including a housing having a transmitter circuit, a source of power for the transmitter circuit and transmitter antenna means installed therein,
>
> the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and
>
> said means responsive to the opening of the door including means to enable the receiving circuit in the sensing module whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response for energizing the alarm means."

REASONS FOR ALLOWANCE OF WRIT

I. Summary

Each of the three questions presented for review relate to an aspect of the decision in this case that will make it difficult to know with certainty the scope of claims and thus more difficult to know with certainty what the public is free to do and what will infringe upon the patent rights of another.

Initially, the second question presented for review relates to the same point of law as another case for which this Court has recently granted a petition for a writ of certiorari, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 00-1543 (case before the U.S. Court of Appeals for the Federal Circuit reported in 187 F.3d 1381, 51 U.S.P.Q. 1959 (Fed. Cir. 1999)). This case provides an example of how the decision in *Festo, supra* is being applied. The Petitioner suggests that this petition be granted and either be heard with the *Festo* case which is now before this Court, or be delayed until this Court has decided the *Festo* case, so that this case can be remanded for interpretation in the light of the decision of this Court in *Festo, supra,* if this Court should overrule or modify the lower Court's decision in *Festo, supra.*

The first question presented for review relates to a conflict between the decision in this case between Senior Technologies, Inc. and R.F. Technologies, Inc. and in the previous cases of *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895) and *Renishaw PLC v. Marposs Societa' Per Azioni,* 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), as to when a

limitation can be construed to be in a claim if it is not already recited in the claim.

The second question presented for review relates to whether the amendment of a claim to refer back to a limitation recited in the original claim by repeating the limitation creates file wrapper estoppel. This question may involve the interpretation of the holding in *Festo, supra* that applies file wrapper estoppel to prevent the application of the doctrine of equivalents for any amendment related to patentability. This interpretation of *Festo, supra* conflicts with the decision in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040, 137 L.Ed. 2d 146 (1997).

The third question presented for review, while involving the scope of application of the doctrine of equivalents, relates most directly to the applicability of the doctrine of equivalents to expand the scope of a limitation construed to be in a claim. It thus involves both the *Festo* decision and another decision, *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996). *Athletic, supra* construed a claim to contain a limitation and refused to apply the doctrine of equivalents because expanding the construed limitation would eviscerate the construed limitation.

II. First question presented for review - Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?

A. Federal Question–Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

This case provides a new criteria for construing a claim to include a limitation not recited in the claim. This criteria appears to conflict with the long established law in which a limitation should not be imported into a claim unless it is necessary to rely on the limitation to determine what is meant by a limitation already in the claim, *Renishaw PLC v. Marposs Societa' Per Azioni,* 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), *McCarty v. Lehigh Valley R. Co.,* 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895). Because literal infringement occurs only if the accused device contains every limitation in the claim, *North American Vaccine, Inc. v. American Cyanamid Co.,* 7 F.3d 1571; 28 USPQ2d 1333 (Fed. Cir. 1993), *cert. denied,* uncertainty as to the circumstances under which a limitation can be construed to be in a claim creates a corresponding uncertainty as to what the public can do and what would infringe on a patentee's rights. It is not clear how this new criteria applied by the Court of Appeals differs from reading a limitation into the claim from the specification, which is improper, *Renishaw, supra,* nor is it clear which limitations in the specification can be construed to be in the claim to limit its scope.

The new criteria construes a limitation to be in a claim when that limitation is associated in the description of the preferred embodiment with other limitations in the claim. In this case, the new criteria construes claim 1 to include the recitation of a sensing-module housing which is not literally recited in the claim, by referring to the specification and to another independent claim, claim 6, to determine that a sensing

means and a receiving circuit are in the same sensing-module housing and therefore, there must be a sensing-module housing.

More specifically, the Court of Appeals finds that the receiving circuit 14 is within the sensing module 14 and the sensing means is also part of the sensing module, and from that concludes the claim must be limited to a sensing-module housing 174. Although it does not appear to be significant, the Court of Appeals also states that the specification refers to the physical sensing module as being a sensing-module housing, but the specification does not refer to the physical sensing module as a sensing-module housing and clearly distinguishes the two. That statement may have been triggered by Figure 5 in which the sensing-module housing is indicated by the numeral 174 with a lead line entering the sensing-module housing and the sensing receiver or sensing module 14 is indicated by the lead line and arrow head spaced from the total unit including the sensing-module housing 174. The specific language used in this construction is:

> "Claim 1 describes a monitoring system that includes a 'sensing module for installing adjacent to a door opening to be monitored.' This sensing module, according to the claim, 'includ[es] a receiving circuit and associated sensing means.' Furthermore, claim 1 mentions a 'means to enable the receiving circuit <u>in the sensing module</u> . . . .' (emphasis added). Based on the language of the claim, one must conclude that the receiving circuit must be contained within the sensing module. This position is

consistent with the text and figures in the written description. Although the specification refers to the physical sensing module as a 'housing,' it is clear that the receiving circuit is located within it:

> The switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiver circuit 14 is located. The housing 174 has an output cable 176 which connects it to a remote nursing station. . . .

'155 patent, col. 8, lines 8-11. Furthermore, the prosecution history reveals that, in order 'to clarify ambiguities,' claim 1 was amended such that 'the receiving circuit' would be specifically located 'in the sensing module.' Hence, the claim language, specification, and prosecution history all indicate that the receiving circuit must be contained within the housing of the sensing module."

(Appendix A, page 10, beginning with the last paragraph)

and:

"A limitation not clearly addressed by the district court was the location of the "associated sensing means" in claim 1. As a matter of law, we conclude that the

> "associated sensing means" in claim 1 must be located within the same housing as the receiving circuit."
>
> (Appendix A, page 14, third paragraph)

The sensing-module housing for the receiver is referred to only in column 8 of the specification, lines 9 and 10, which describe the mechanical connection of the cables as quoted above. It is shown in Figures 6, 7, and 8, but is only indicated by its reference numeral 174 in Figure 5.

The sensing module or receiver circuit 14 is referred to throughout the specification most notably in: column 1, lines 15, and 55; column 2, lines 6, 8, 58 and 59; column 3, lines 7, 8, and 54; column 4, lines 27, and 36; column 5, lines 61 and 62; column 6, lines 44, 49, 54 and 59; column 7, line 50 and column 8, lines 16 (part of receiver or sensing module), 18, 24 and 36. The receiver is described as being in the sensing-module housing in the specification and is shown in two of the drawings as being in the sensing-module housing. The sensing means (antenna) is described in one embodiment as being in the sensing-module housing and in another as being on the door (Appendix A, pages 14-16).

The sensing module is not recited as a means plus function clause in claim 1 and there appears to be no other reason for construing this claim to include a sensing-module housing for the receiver other than the description in the specification which must describe the best mode of protecting the invention under 35 U.S.C. 112. The statute does not forbid a description of more

than one mode but only requires the description of the best mode. The Court of Appeals does not hold that it is essential to interpret the sensing module as being the sensing-module housing, and it is not necessary since the entire sensing module is shown and indicated by reference numeral 14 in Figure 4 of U.S. Patent 4,682,155 (see Appendix C, page 66).

Moreover, as stated by the Court of Appeals (Appendix A, page 15), the dependent claim 4 has language further limiting claim 1, although the Court of Appeals states it describes a different embodiment than claim 1. I cannot be directed to a different embodiment and still incorporate claim 1 by reference. Instead it is following 35 U.S.C. 112, which states in paragraphs 3 and 4:

> "A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.
>
> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers."

Claim 4 supports a construction that the sensing means may be outside of any sensing-module housing rather than supporting the construction that the sensing means and receiving circuit must be within the unrecited sensing-module housing. Moreover, the ordinary and usual meaning of the words, "associated with" is not "part of" but is "connected with" as an

outside television antenna can be connected by a long wire to an inside television set.

This manner of construing claims will create uncertainty in deciding when a claim is infringed and when a claim is valid since it appears to enable claims to be construed as including many limitations referring to an element in the claims that is described in the specification as being associated with a claimed element. There is no guidance concerning what details of the preferred embodiment can be construed into the claim and which cannot.

B. Conflict With Other Decisions

This case appears to be in direct conflict with *Renishaw PLC v. Marposs Societa' Per Azioni,* 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), cited by the U.S. Court of Appeals for the Federal Circuit, as well as with *McCarty v. Lehigh Valley R. Co.,* 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895). These cases indicate that a limitation should not be imported into a claim unless it is necessary to rely on the limitation to determine what is meant by the limitation expressed in the claim. The rational for this holding was provided in *McCarty, supra* as follows:

> "[W]e know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim . . ., we should never know

where to stop."

McCarty v. Lehigh Valley R. Co., 160 U.S. 110, 116.

There is no need to further define the term "sensing module" by adding a new limitation in the claim nor does the Court of Appeals base its opinion on such a need. There is no issue relating to validity that involves a sensing-module housing in the lower Court's findings of fact and conclusions of law (see conclusions of law 32-41 in Appendix C, pages 58-61) and the sensing-module housing does not play a role in the reception of the radio signal nor its application. There is no indication in this record that either the applicant or the examiner thought claim 1 to be limited by the recitation of a sensing-module housing when claim 1 was allowed.

III. Second question presented for review -- Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999)?

A. Federal Question–Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

In its decision on alternative grounds, this Court of Appeals held the doctrine of equivalents could not expand the scope of claim 1 because of file wrapper estoppel. It held there was file wrapper estoppel on the

ground that claim 1 was amended such that "the receiving circuit" would be specifically located "in the sensing module." The record, on the other hand, shows that this limitation was in the original claim 1 and the amendment that is being discussed was not to cure an ambiguity as to the scope of the claim, but to conform a second recitation of a limitation to the first recitation of the limitation. The Court of Appeals relies on *Festo, supra* in its opinion. Thus *Festo, supra* is extended to cause editorial changes made to a claim that do not expressly limit the scope of the claim in themselves to create file wrapper estoppel. This extension will limit the ability of applicants and examiners in the United States Patent and Trademark Office to agree on editorial changes. It also raises issues that will cause doubt as to the scope of claims, such as how trivial must an editorial change be before it will not create file wrapper estoppel.

Claim 1 was amended after being rejected under 35 U.S.C. 112, second paragraph, as being indefinite in an Office action dated October 31, 1986 (page A001378 of the Joint Appendix before the Court of Appeals). That paragraph recited a number of other rejections under 35 U.S.C. 112, second paragraph, of a generally editorial nature, such as being unclear or containing typographical errors, such as "in" should be "is", or "transmitter" should read "transmitting". The applicant responded by making several changes to claim 1 (page A001382 of the Joint Appendix before the Court of Appeals) the relevant changes being to amend claim 1 from reading:

> "Claim 1.
>
> * * *
>
> ...a sensing module for installing adjacent

to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the trigger module to produce an output response...

* * *

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and,

means to enable the receiving circuit in response to the opening of the door whereby..."

to:

"Claim 1.

* * *

...a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response...

* * *

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and

said means responsive to the opening of the door including means to

> enable the receiving circuit in the sensing module whereby..."

The amended claim includes the same limitations as the claim before being amended except stated differently in two respects, namely: (1) both versions of claim 1 recite "...means responsive to the opening of the door to enable the sensing module to respond..." (starting on line 3 of each version of claim 1 quoted above), but later the second version recites:

> "said means responsive to the opening of the door including means to enable the receiving circuit..."

whereas the unamended version only again recites:

> "means to enable the receiving circuit in response to the opening of the door..."

and (2) both versions of claim 1 recite "the sensing module including a receiving circuit and associated sensing means..." but while the unamended version never repeats that the receiving circuit is in the sensing module, the amended version does repeat this statement at the end of the clause quoted above as follows:

> "...means to enable the receiving circuit in the sensing module..."

The differences between the amended and unamended versions do not relate to any new limitation but only to the manner in which the limitations are

expressed. Moreover, the amendments do not implicate prior art or validity over prior art.

Thus the original claim contained the limitation in issue in the fourth paragraph and the amendment to the fifth paragraph was made to change "response to the opening of the door" to correspond to language in the earlier phrase "means responsive to the opening of the door" in the second paragraph. For consistency, with the limitation of the "sensing module including a receiving circuit" in paragraph 4, the limitation was restated in paragraph 5 as "receiving circuit in the sensing module" for clarity. More importantly, the same limitation was already in the claim because the language "sensing module including a receiving circuit" is the same as "receiving circuit in the sensing module".

This interpretation of "sensing module" is consistent with the ordinary meaning of the word "module" as being a group of components and with the use of "module" in the specification. When referring to a group of components (i.e. sensing module), to say that a component (i.e. receiving circuit) is in the group of components (i.e. sensing module) or within that group of components is the same as saying that the group of components (i.e. sensing module) includes the component (i.e. receiving circuit).

B. Conflict With Other Decisions

This case appears to conflict with *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040; 137 L.Ed. 2d 146 (1997) in which this Court endorsed a compromise between the notice function of claims and fair protection objectives of

claims. That compromise was to limit the application of the doctrine of equivalents to the substitution of an element recited in a claim with an equivalent element but not to apply the doctrine of equivalents to the invention as a whole. 520 U.S. 17 at 29. The Court expressly rejected the position that the reason for an amendment is irrelevant to file wrapper estoppel limiting the doctrine of equivalents. 520 U.S. 17 at 30 and 31.

In this case, file wrapper estoppel is applied to prevent the doctrine of equivalents related to an amendment that conformed language in a later portion of a claim to language already in the originally filed claim at an earlier location. There is no explanation given for refusing to apply the doctrine of equivalents to this single element except to cite *Festo, supra*, although the construed limitation could have nothing to do with prior art.

IV. Third question presented for review -- May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be expanded under the doctrine of equivalents?

A. Federal Question–Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

The Court of Appeals denied the application of the doctrine of equivalents on another ground in addition to *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Circ. 1999) but one which raises the same questions about limitations on the doctrine of equivalents as raised by *Festo, supra*.

In this ground, the Court of Appeals cites *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581, 1582-83, 37 USPQ2d 1365, 1372, 1373-74 (Fed. Circ. 1996), as indicating that once the "receiver circuit and associated sensing means" are construed as being in the unrecited "housing", the doctrine of equivalents cannot expand the claim to include the associated sensing means as being outside of the unrecited sensing-module housing. In this case, the construed limitation "housing" was not put in the claim because of prior art but appears to be in the claim because the specification mentions it and the drawings show it, presumably as part of the description of the preferred embodiment.

However, this appears to be the product of a mistake in the role or lack of role played by the sensing-module housing in this invention. In *Athletic, supra,* the dispute was over the interpretation of a vital part of the invention recited in the claims, namely (strings of a tennis racket) "vary continuously between a maximum of d1=1/2 inch in the center, to zero for the last lateral strings near the tip and the heel of the frame". This recitation was inserted to distinguish over a reference to Lewis in which the splay did not vary. 73 F.3d 1573 at 1575. The Court of Appeals found the language susceptible of two meanings, one in which only two strings were necessary, resulting in infringement and one in which at least three strings were necessary resulting in no infringement, depending on which of two possible meanings of the word, "between" was accepted. 73 F.3d 1573 at 1579.

The Court of Appeals in *Athletic, supra* referred to documents and file wrapper comments indicating that three strings were required and referred to logic

explaining that in order to vary between one string and another requires a string between the two extremes. The opponent argued that there only had to be two strings. The Court of Appeals construed this clause, not to add elements because the strings were already recited, but to resolve the logical dispute over the scope of invention by interpreting language at the heart of the invention in a manner to distinguish over prior art.

Unlike *Athletic, supra*, in this case, the dispute resolves around what must be in a sensing-module housing and the only prior art question before the Court of Appeals relates to the existence of an "on sale" or "public use bar" under 35 U.S.C. 102. Section 102 of 35 U.S.C. bars protection if the invention was on sale or in public use more than one year before filing its application. This prior art did not hinge on the sensing-module housing at all. The problem centers on the failure of the decision to say why the sensing-module housing may be construed as being in claim 1, before showing that, if the sensing-module housing is construed to be in claim 1, then the receiver and sensing means must be in the sensing-module housing if only the sensing-module housing were in claim 1. There is a missing step about an insignificant part of a radio receiver, the sensing-module housing.

There is a good reason why the sensing-module housing was not recited in claim 1. The sensing-module housing does not play a role in detecting wanderers nor in performing any of the functions of the recited components such as transmitting, sensing or receiving. Unlike *Athletic, supra* (see 73 F.3d 1573 at 1581), this record does not contain any evidence that the examiner thought claim 1 was limited by a sensing-module housing or any evidence the examiner allowed claim 1

because of such a limitation or that the applicant intended such a limitation in claim 1. The word "housing" has no more connection to claim 1 than any other piece of hardware that is mentioned in the specification but not recited in claim 1, nor is there any confusion about the meaning of terms.

There is no mention of a sensing-module housing at all in this claim but only the functional language referring to the active electrical components such as "sensing module". There is no file wrapper estoppel relating to prior art and a full range of equivalents should be permitted. Clearly the sensing module can perform its function of sensing independently of an inanimate sensing-module housing which, according to its usual and common meaning, is nothing more than a cabinet used to carry the functional elements from place to place and to protect them from the elements. It does not perform and can not perform a function of sensing.

The word "module" also has a common and ordinary meaning. It means a group of functional units. This meaning is supported by the specification and record. For example, in the specification of the patent-in-suit, U.S. Patent 4,682,155, reference is made to "trigger modules" in column 1, lines 11-12 and 17-18 (page A000081 of the Joint Appendix before the Court of Appeals), and in other places. Reference is made to "transmitter modules" in column 1, lines 53-54 (page A000081 of the Joint Appendix before the Court of Appeals), and in column 6, line 40 (page A000083 of the Joint Appendix before the Court of Appeals), and in other places. Reference is made to "transmitter and receiver modules" in column 2, lines 7-8 (page A000081 of the Joint Appendix before the Court of Appeals), and in column 4, line 27 (page A000082 of the Joint

Appendix before the Court of Appeals); and to "transmitter module or unit" in column 3, lines 24-25 (page A000082 of the Joint Appendix before the Court of Appeals). Reference is made to "receiver unit or module" in column 1, line 15 (page A000081 of the Joint Appendix before the Court of Appeals), and so on. The specification is full of uses of the word "module" indicating a functional group and not suggesting that modules need a housing or have a housing or don't need a housing or don't have a housing.

For example, it can be noted that in column 3 (page A000082 of the Joint Appendix before the Court of Appeals), the actual words "sensing module" used in line 54 are indicated by the numeral 14 which is shown in Figure 3 as indicating a block diagram of the functional units and in Figure 4 indicating the circuitry. In Figure 4, there is no indication at all of a sensing-module housing and it is a schematic circuit diagram showing only components. Clearly the specification does not support the reading of the sensing module in the alternative ground for noninfringement as being or including a sensing-module housing. Its meaning is much broader in terms of the ordinary and common use of the word "module", and the manner in which the word "module" is utilized as a word in the specification of the patent. While modules of any kind can be inside of and include housings, there is nothing in this record to indicate they must include or be in a housing by their nature. They are nothing more than components gathered together to perform a function as shown consistently by the language and as indicated by the common and ordinary usage.

This reasoning seems to apply even more strongly to the CA9000 model since the Court of Appeals held

(Appendix A, page 13, third paragraph, through page 14, first paragraph):

> "Contrary to the district court's determination, the CA9000 model could arguably meet the single housing requirement since the microprocessor and the preceding circuitry can be found in the same housing (i.e., the control unit). However, in the CA9100, CA9120, and CA600, the circuitry preceding the microprocessor was removed and placed in the antenna unit mounted near the door, while the microprocessor remained in the control unit. As discussed above, both the microprocessor and the preceding circuitry corresponds to the limitation of "receiving circuit" in the '155 patent. By splitting the microprocessor and the preceding circuitry between two housings (i.e., the control unit and the antenna unit), these Code Alert products ceased to literally embody the single housing limitation of claims 1 and 6.
>
> As far as infringement under the doctrine of equivalents is concerned, both claims 1 and 6 were amended to overcome a rejection under 35 U.S.C. § 112, ¶ 2 (1994). Claim 1 was amended such that the receiving circuit is "in the sensing module," whereas claim 6 was amended to involve "a housing and a receiving circuit therein." Therefore, infringement under the doctrine of equivalents with regard to the CA9100, CA9120, and CA600 models is precluded. See Festo Corp., 2000 U.S. App. LEXIS 29979, at *25."

B. Conflict With Other Decisions

This case also appears to conflict with *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040; 137 L.Ed. 2d 146 (1997) in its reliance on *Athletic, supra* in a manner similar to the conflict when the Court of Appeals relied on the *Festo, supra* case. In *Warner-Jenkinson, supra*, this Court provided a compromise between the notice function of claims and the fair protection objective of claims. That compromise was to limit the application of the doctrine of equivalents to the substitution of an element recited in a claim with an equivalent element but not to apply the doctrine to the invention as a whole. 520 U.S. 17 at 29. The Court expressly rejected the position that the reason for an amendment is irrelevant to file wrapper estoppel limiting the doctrine of equivalents. 520 U.S. 17 at 30 and 31.

In this case, the fact that an element was construed as being in the claim is applied to prevent the doctrine of equivalents related to that limitation construed to be in the claim. The construction of the claim to include an element for reasons not related to prior art or any other substantial reason related to patentablity creates the same conflict between fair interpretation of the claim and predictability that was resolved by this Court in *Warner-Jenkinson, supra*. It should be resolved in the same manner.

V. CONCLUSION

The first question presented for review is to resolve confusion under the decision of the Court of Appeals about when a limitation can be construed to be in a

claim and the second and third questions presented for review are to resolve confusion under the decision of the Court of Appeals over when file wrapper estoppel will bar the application of the doctrine of equivalents from broadening the scope of a claim.

Under the second and third questions, the decision before this Court creates uncertainty as to what amendments can be safely made during examination of a patent application. Can the applicant correct spelling mistakes or grammatical mistakes, or as specifically involved here, can the applicant conform the language in one part of a claim to another part of the claim without waiving the doctrine of equivalents? Each of the questions relates to a conflict with existing case law. The questions are significant because this case leaves doubt as to what limitations can be added to claims from the specification and thus what the public may or may not do without infringing upon a patentee's rights.

Respectfully submitted,

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Supreme Court, U.S.
FILED

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OFFICE OF THE

No.

IN THE

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ of Certiorari
To The U.S. Court of Appeals for the Federal Circuit

APPENDIX

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APPENDIX A

NOTE: Pursuant to Fed. Cir., R. 47.6, this disposition is not citable as precendent. It is a public record. This disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

00-1089, -1090

SENIOR TECHNOLOGIES, INC.,

Plaintiff-Appellant,

v.

R.F. TECHNOLOGIES, INC.,

Defendant-Cross Appellant.

DECIDED: March 12, 2001

Before CLEVENGER, Circuit Judge, SMITH, Senior Circuit Judge,*[1] and BRYSON, Circuit Judge.

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* Senior Judge Smith heard oral argument in this case but because of illness was unable to participate in the disposition. This case was decided by the remaining judges in accordance with Fed. Cir. R. 47.11.

CLEVENGER, Circuit Judge.

Senior Technologies, Inc. ("Senior Tech") appeals a decision of noninfringement in favor of one of its competitors, R.F. Technologies, Inc. ("R.F. Tech") upon the conclusion of a bench trial by the United States District Court for the District of Nebraska. See Senior Tech., Inc. v. R.F. Tech., 58 F. Supp. 2d 1076 (D. Neb. 1999). R.F. Tech cross-appeals the district court's ruling on the issues of claim definiteness, invalidity, inequitable conduct, and attorneys' fees. Because the district court's conclusion of noninfringement was correct with respect to each of R.F. Tech's Code Alert products, and since it did not commit reversible error in its treatment of any of the remaining issues, we affirm.

I

Senior Tech is the holder of U.S. Patent No. 4,682,155 ("the '155 patent"), entitled "Personnel Security System," which issued on July 21, 1987. The '155 patent is generally directed to a wanderer monitoring system which can be used in nursing homes, hospitals, assisted living centers, and other care facilities to monitor patients or residents who have a tendency to wander. The invention provides for the sounding of an alarm when a resident attempts to leave the facility, thereby alerting staff members so that appropriate action can be taken.

Two independent claims of the '155 patent, claims 1 and 6, are alleged by Senior Tech to be infringed by products made by R.F. Tech. These claims read in relevant part with emphases added to highlight the disputed terms:

1. A security sensing system for monitoring the passage of persons through a door or like opening comprising:

[1] a transmitter module for installing on persons to be monitored, [2] a sensing module for installing adjacent to a door opening to be monitored, and [3] means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response, and [4] alarm means energizable in response to the production of the output response to produce an alarm condition,

....

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and

said means responsive to the opening of the door including means to enable the receiving circuit in the sensing module whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response for energizing the alarm means.

'155 patent, col. 8, line 57 through col. 9, line 13 (emphasis added).

6. Means to monitor a doorway of a nursing home or other institution in order to produce an alarm when certain residents try to pass therethrough comprising

> a transmitter device ....
>
> a receiving device for mounting adjacent to the doorway including [1] a housing and a receiving circuit therein, [2] a signal sensor operatively connected to the receiving circuit, [3] means for supplying power to the receiving circuit, [4] means to enable the receiving circuit, and [5] an output for the receiving circuit,
>
> an alarm producing device operatively connected to the output of the receiving circuit, and
>
> said means to enable including switch means operatively connected to the receiving circuit . . . the switch means operating to enable the receiving circuit.

'155 patent, col. 9, lines 31-53 (emphasis added).

In general terms, the invention of the '155 patent begins with a transmitter, typically worn on the wrists or ankles of a person being monitored. The transmitter continuously transmits a signal that, if within range, can be received by the antenna of a fixed unit mounted near a door opening. Contained within the housing of the fixed unit is what the '155 patent refers to as "a receiving circuit." The function of the receiving circuit is to take the signal picked up by the antenna, and, depending on whether or not the door being monitored is open, generate an output signal that sounds an alarm.

R.F. Tech engages in the business of designing, engineering, manufacturing, and selling a variety of

medical monitoring equipment, including wanderer monitoring systems. Since 1992, it has sold wanderer monitoring systems under the trademark "Code Alert." Four models of the Code Alert products are the subject of this suit: the CA9000, CA9100, CA9120, and CA600.

All of the Code Alert products associated with this litigation involve transmitters to be worn by those persons being monitored. In addition, the CA9000, first introduced in 1992, included an antenna mounted near a doorway, a control unit containing a microprocessor and additional circuitry, and a door switch connected to the control unit's microprocessor. The CA9100, introduced in 1994, differed from the CA9000 in that the circuitry located originally in the control unit was removed and placed in the antenna mounted near the door. The microprocessor, however, remained in the control unit. The CA9120 and the CA600, introduced in 1995 and 1998 respectively, possessed the same relevant features as the CA9100 for purposes of this appeal.

II

An infringement analysis is "a two-step process in which we first determine the correct claim scope, and then compare the properly construed claim to the accused device to determine whether all of the claim limitations are present either literally or by a substantial equivalent." Renishaw PLC v. Marposs Societa' Per Azioni, 158 F.3d 1243, 1247-48, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998). We review the first step of claim construction without deference to the district court. Id.; Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1455, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc).

When infringement is tried to the bench, we review the second step of comparing the properly construed claim to the accused device for clear error. See Young Dental Mfg. Co. v. Q3 Special Prods., Inc., 112 F.3d 1137, 1141, 42 USPQ2d 1589, 1592 (Fed. Cir. 1997).

In properly determining the scope and meaning of a claim, it is well-settled that the court should first look to the intrinsic evidence of record, i.e., the patent itself, including the claims, the written description and, if in evidence, the prosecution history. See Markman v. Westview Instruments, Inc., 52 F.3d 967, 979-80, 34 USPQ2d 1321, 1329-30 (Fed. Cir. 1995). Such intrinsic evidence is the most significant source for determining the operative meaning of disputed claim language. Among these sources, the claim language itself is always the starting point of claim construction. See Johnson Worldwide Associates, Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999). Terms in the claim are to be given their ordinary and accustomed meaning to a person of ordinary skill in the relevant art. See Renishaw, 158 F.3d at 1249, 48 USPQ2d at 1121. However, an exception arises when either "a different meaning is clearly set forth in the specification or where the accustomed meaning would deprive the claim of clarity." Northern Telecom Ltd. v. Samsung Elec. Co., 215 F.3d 1281, 1287, 55 USPQ2d 1065, 1069 (Fed. Cir. 2000); see also Johnson Worldwide, 175 F.3d at 990, 50 USPQ2d at 1610. Furthermore, one may look to the written description to define a term in the claims, for "a claim must be read in view of the specification of which it is a part." Renishaw, 158 F.3d at 1248, 48 USPQ2d at 1120. However, one should avoid reading a limitation into a claim from the written description, and, in so doing, restricting its scope unduly. Id. Finally, statements and amendments

contained in the prosecution history can often inform one's construction of a claim, particularly if they were made for reasons of patentability. See Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 862-63, 20 USPQ2d 1252, 1262 (Fed. Cir. 1991)(affirming the use of prosecution history to construe a claim).

To infringe, an accused device must embody every limitation in the claim, either literally or under the doctrine of equivalents. See Zelinski v. Brunswick Corp., 185 F.3d 1311, 1316, 51 USPQ2d 1590, 1593 (Fed. Cir. 1999); see also American Permahedge v. Barcana, Inc., 105 F.3d 1441, 1445, 41 USPQ2d 1614, 1618 (Fed. Cir. 1997). However, the application of the doctrine of equivalents is limited by the doctrine of prosecution history estoppel, which bars a patentee from asserting as an equivalent subject matter previously surrendered during the prosecution of the patent application. Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579, 34 USPQ2d 1673, 1679 (Fed. Cir. 1995). Furthermore, a narrowing amendment made for any reason related to the statutory requirements for a patent will trigger prosecution history estoppel with respect to the amended claim element. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., No. 95-1066, 2000 U.S. App. LEXIS 29979, at *16 (Fed. Cir. Nov. 29, 2000) (en banc). Finally, when a claim amendment creates prosecution history estoppel, there is no range of equivalents available for the amended claim element. Id. at *25.

A

The first issue is whether the district court correctly treated the phrase "receiving circuit" in its claim construction and in its comparison of the construed

claims to the accused device.

Senior Tech's lead argument on appeal is that the district court erred in "construing" the receiving circuit so as to encompass circuitry in the accused Code Alert products which (1) produces no output signal to energize an alarm, and (2) is not connected to a door switch, an interpretation "which contradicts language explicitly recited in the claims themselves." Senior Tech contends that the district court should not have excluded the Code Alert microprocessor from the part of the accused product that would be compared against the "receiving circuit" limitation in the '155 patent. Technically, Senior Tech's contention is not an attack on the district court's claim construction. Rather, the challenge relates to the second step of the infringement analysis, namely, that the district court committed clear error in its comparison of the construed claims to the accused device. Hence, the district court's construction of "receiving circuit" as it relates to claims 1 and 6 of the '155 patent is not in genuine dispute, and need not be reviewed by us.

In defining "receiving circuit" and its functions in terms of Fig. 4 of the specification, the district court made the following findings:

> The receiving circuit disclosed in the '155 Patent which is located in the sensing module consists of the AM radio, signal limiter, tone decoder, initial power turn-on delay, low-frequency filter, output stage, and lead 67. In Fig. 4, the receiv[ing circuit] extends to the left of the point where resistor 136, diode 138, and the unnumbered relay contact directly above the connect. The principal function of the receiving

> circuit 14 is to accept an input signal received from the wanderer's transmitter, process its signal in the successive stages of the receiver, and deliver that signal through the transistor 112 to an output stage to produce a response to energize the alarm.

Senior Tech, 58 F. Supp. 2d at 1082.

Given this definition of "receiving circuit" and its functions, we must turn to the district court's comparison of the '155 patent's "receiving circuit" with a corresponding part in the accused products. After reviewing the evidence before the district court, we are convinced that it committed clear error when it failed to include the microprocessor within the relevant portion of the Code Alert products that ought to be compared against the '155 patent's "receiving circuit."

In its opinion, the district court labeled, without any explanation, the circuitry preceding the microprocessor in the Code Alert device as "a receiving circuit." See Senior Tech, 58 F. Supp. 2d at 1083 (Finding of Fact No. 18). However, the district court's own findings indicate that the principal functions of the receiving circuit are to (1) accept an input signal received from a transmitter of a monitored person, (2) process its signal in successive stages, and (3) deliver that signal to an output stage to produce a response to energize an alarm. The above functions indicate that the microprocessor, whose output is connected to an alarm, should have properly been included in the portion of the accused device that would be compared against the "receiving circuit" in the '155 patent.

Therefore, the district court erred by not including

the microprocessor in its comparison of the accused device with the construed "receiving circuit." When the functions of the microprocessor are properly understood, and the claim is read on those functions, the presence of the microprocessor in the accused device provides no ground for noninfringement of the claims.

We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us. See MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1366, 52 USPQ2d 1303, 1306 (Fed. Cir. 1999) ("'[A]ppellees always have the right to assert alternative grounds for affirming the judgment that are supported by the record.'" (quoting Datascope Corp. v. SMEC, Inc., 879 F.2d 820, 822 n.1, 11 USPQ2d 1321, 1322 n.1 (Fed. Cir. 1989)).

B

Another issue before the district court was whether the '155 patent disclosed a limitation of a single housing within which lies the receiving circuit. As a matter of law, we conclude that both claims 1 and 6 do include such a limitation.

Claim 1 describes a monitoring system that includes a "sensing module for installing adjacent to a door opening to be monitored." This sensing module, according to the claim, "includ[es] a receiving circuit and associated sensing means." Furthermore, claim 1 mentions a "means to enable the receiving circuit in the sensing module . . . ." (emphasis added). Based on the language of the claim, one must conclude that the receiving circuit must be contained within the sensing module. This position is consistent with the text and

figures in the written description. Although the specification refers to the physical sensing module as a "housing," it is clear that the receiving circuit is located within it:

> The switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiver circuit 14 is located. The housing 174 has an output cable 176 which connects it to a remote nursing station . . . .

'155 patent, col. 8, lines 8-11. Furthermore, the prosecution history reveals that, in order "to clarify ambiguities," claim 1 was amended such that "the receiving circuit" would be specifically located "in the sensing module." Hence, the claim language, specification, and prosecution history all indicate that the receiving circuit must be contained within the housing of the sensing module.

Claim 6 similarly describes a monitoring system that requires "a housing and a receiving circuit therein." According to the plain meaning of the claim language, claim 6 clearly states the requirement of a separate housing structure within which lies a receiving circuit. Moreover, the same passage from the specification mentioned above confirms this interpretation in that the "switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiv[ing] circuit is located." Id. (emphasis added). Finally, the prosecution history reveals that originally, claim 6 merely listed "a housing" and "a receiving circuit" as the first two of several elements comprising the "receiving device." Had the claim been left unamended, one could argue that the claim language contains no requirement for the receiving circuit to be located within a housing. The list, however,

was specifically amended to combine the first two elements into one by changing the language to read "a housing and a receiving circuit therein." Faced with such an explicit amendment, the appellant cannot now argue that claim 6 does not require a housing within which lies a receiving circuit. Thus, the claim language, the specification, and the prosecution history all indicate that claim 6 is limited to a device in which a receiving circuit is located within a housing.

The appellant nevertheless contends that it was improper for the district court to "construe claim 6 as requiring a separate sensing module and receiving circuit that are contained in a single housing." The appellant, however, misinterprets the thrust of the district court's conclusion. As we read its opinion, the district court was not requiring a separate sensing module and a receiving circuit to be contained within a single housing. Rather, it was merely noting that the receiving circuit in the accused product did not literally infringe claim 6 because it was not contained in the housing of the "sensing module" (i.e., the housing of the "receiving device"). Perhaps the district court could have been more precise in its choice of words when it used the phrase, "housing of the sensing module," rather than, more accurately, "housing of the receiving device." However, given the fact that "sensing module" is not mentioned anywhere in the claim, we can justifiably conclude that the district court was not attempting to import an additional limitation of a "separate sensing module." Rather, it was simply referring to the housing of the "receiving device" in claim 6. Furthermore, the context clearly shows that the district court was addressing the infringement issue as to claim 6, not claim 1. Hence, we find no inconsistencies between the district court's statements and an interpretation of claim

6 that requires a "receiving device" that includes "a housing and a receiving circuit therein."

Having properly construed claims 1 and 6 to require a single housing within which lies a receiving circuit, we must review the district court's comparison of the construed claim to the accused device. As to claim 1, the district court found that "the accused products do not have a sensing module with the components described in the claim . . . ." Senior Tech, 58 F. Supp. 2d at 1089. As to claim 6, the district court concluded that the Code Alert products did not literally infringe because "the receiving circuit which responds to signals to produce a response is not contained in the housing of the sensing module." Id.

Contrary to the district court's determination, the CA9000 model could arguably meet the single housing requirement since the microprocessor and the preceding circuitry can be found in the same housing (i.e., the control unit). However, in the CA9100, CA9120, and CA600, the circuitry preceding the microprocessor was removed and placed in the antenna unit mounted near the door, while the microprocessor remained in the control unit. As discussed above, both the microprocessor and the preceding circuitry corresponds to the limitation of "receiving circuit" in the '155 patent. By splitting the microprocessor and the preceding circuitry between two housings (i.e., the control unit and the antenna unit), these Code Alert products ceased to literally embody the single housing limitation of claims 1 and 6.

As far as infringement under the doctrine of equivalents is concerned, both claims 1 and 6 were amended to overcome a rejection under 35 U.S.C. §

112, ¶ 2 (1994). Claim 1 was amended such that the receiving circuit is "in the sensing module," whereas claim 6 was amended to involve "a housing and a receiving circuit therein." Therefore, infringement under the doctrine of equivalents with regard to the CA9100, CA9120, and CA600 models is precluded. See Festo Corp., 2000 U.S. App. LEXIS 29979, at *25.

In light of the foregoing analysis, we can immediately affirm the district court's finding of noninfringement of claims 1 and 6 with respect to the CA9100, CA9120, and CA600. However, since the CA9000 could arguably meet the single housing requirement, we must continue to determine whether this last remaining model could be found to infringe either claim 1 or 6.

C

A limitation not clearly addressed by the district court was the location of the "associated sensing means" in claim 1. As a matter of law, we conclude that the "associated sensing means" in claim 1 must be located within the same housing as the receiving circuit.

As discussed above, we have already construed claim 1 to contain a limitation that requires the receiving circuit to be contained within the housing of the sensing module. Since the sensing module is defined as "including a receiving circuit and associated sensing means," there is no reason for us not to conclude that the associated sensing means must also be contained within that same housing. The written description in the specification reinforces this view by providing that the associated sensing means, comprised of two ferrite inductors, be "connected to a jack 86 for an external sensor . . . ." '155 patent, col. 6, lines 59-63. This

language implies that the associated sensing means must be "internal," as opposed to an "external sensor." Finally, the only indication of anything remotely similar to an external associated sensing means can be found in the illustrations in the '155 patent, where an elongated sensing strip is shown to be connected to the sensing module in Figures 6 and 7. However, the specification makes clear that the sensor strip is used in an alternative embodiment of the invention for a double door opening. '155 patent, col. 8, lines 24-36. This alternative embodiment is described in dependent claim 4 as:

> The security sensing system of claim 1 wherein the door opening accommodates two door members and the sensing module is located adjacent to the door opening and includes an elongated sensing member mounted extending transversely across at least one of the door members in the door opening.

The doctrine of claim differentiation requires us to consider the "elongated sensing member" found in claim 4 and the "associated sensing means" found in claim 1 to be distinct from one another. Otherwise, one or the other would be rendered superfluous. See Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998) (holding that under the doctrine of claim differentiation, a claim should not ordinarily be construed in a manner that renders a related dependent claim superfluous). Hence, we conclude that although alternative embodiments may involve external sensor strips, the "associated sensing means" in claim 1 must be contained within the same housing as the receiving circuit.

Having construed claim 1 so as to require the "associated sensing means" to be located within the same housing as the receiving circuit, we return to the sole remaining accused product, the CA9000, to determine whether the district court's determination of noninfringement was correct. It is undisputed that the CA9000's antenna, the only part in the accused product that corresponds to the "associated sensing means" in claim 1, is not contained within the same housing as the receiving circuit. As found by the district court, the antenna was mounted adjacent to the door, whereas the part of the accused product corresponding to the '155 patent's "receiving circuit" was located in a control unit mounted elsewhere. Hence, the antenna and receiving circuit are not literally contained within the same housing as required by claim 1.

Furthermore, we find that an attempt to expand the scope of claim 1 under the doctrine of equivalents to encompass the accused devices, which have antennae located outside of the receiving circuit's housing, would eviscerate the construed limitation that they be contained within the housing. Hence, by requiring the "associated sensing means" to be contained within the same housing as the receiving circuit, claim 1 excludes from its scope antennae located outside of the housing. See, e.g., Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573, 1581, 1582-83, 37 USPQ2d 1365, 1372, 1373-74 (Fed. Cir. 1996) (holding that a device "with only two offset distances" was "specifically excluded from the scope of the claims" because the relevant claim had been construed to require the "offset distance [to] take on at least three values"). Therefore, Senior Tech cannot utilize the doctrine of equivalents to reach the Code Alert products, and we must affirm the district court's conclusion of noninfringement of CA9000, both

literally and under the doctrine of equivalents, with regards to claim 1.

We are, however, not finished with the issue of infringement. We must determine whether the CA9000 can be found to infringe claim 6 of the '155 patent, which requires us to address the last claim construction issue.

D

The remaining issue of claim construction relates to the phrase "to enable the receiving circuit" in both claims 1 and 6. The language in the two claims contains subtle differences, and hence, will be analyzed separately. In short, we construe claim 1 to disclose an embodiment in which only the receiving circuit's output is enabled ("partial enablement"), whereas claim 6 discloses an embodiment in which the entire receiving circuit is enabled ("total enablement"), including its receiving function.

The district court construed "enable" so that both claims 1 and 6 "disclose a receiving circuit that can receive signals when the door is open, but cannot when the door is closed." Senior Tech, 58 F. Supp. 2d at 1088. We conclude that the district court's construction was correct as to claim 6, but not as to claim 1.

Claim 6 contains the language "to enable the receiving circuit" in two places. '155 patent, col. 9, lines 43-44, 53. However, in each instance, the phrase exists in bare form and is not qualified by additional limitations. The situation is strikingly different with claim 1. There, as in claim 6, phrases containing the critical word "enable" appear twice. However, in each

instance, the phrase is qualified by additional limitations. In the first mention, "to enable the sensing module" is qualified by "to respond to the signal transmitted by the transmitter to produce an output response." Id., col. 8, lines 63-66 (emphasis added). In the second mention, "to enable the receiving circuit in the sensing module" is qualified by "whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response . . . ." Id., col. 9, lines 9-12. Hence, by virtue of the plain language of the claims, what is being enabled in claim 1 appears to be different than what is being enabled in claim 6.

The specification likewise seems to imply that the receiving circuit can be "enabled" in two different ways. On the one hand, the schematic in Figure 4 and the corresponding description support the notion that the invention involves partial enablement, i.e., that part of the receiving circuit can constantly receive signals, but another part must be "enabled" to respond and to produce an output response.[1] On the other hand, the specification contains several passages clearly indicating that the invention involves total enablement. That is, unless the receiving circuit has been "enabled," it is inoperative with respect to all of its functions--receiving signals, responding to them, or producing an output

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[1] The district court recognizes this notion in its findings of fact number 16, where it states, "[t]he door switch electrically disconnects the left-hand part of the receiving circuit from the right-hand part of the receiving circuit. While the left hand is still operating, the right hand is inoperable, or disabled." Senior Tech, 58 F. Supp. 2d at 1082-83. Hence, while it is apparent that "transistor 112 can receive no signal when the door is closed," id., the receiving circuit as a whole can indeed receive signals transmitted by the transmitters worn by the wanderers.

response.[2] Although the apparent inconsistencies in the specification gives us cause for some concern, we are persuaded that we should attempt to construe the claims to preserve the patent's validity. See Modine Mfg. Co. v. United States Int'l Trade Comm'n, 75 F.3d 1545, 1557, 37 USPQ2d 1609, 1617 (Fed. Cir. 1996) ("When claims are amenable to more than one construction, they should when reasonably possible be interpreted so as to preserve their validity."). Hence, in an attempt to reconcile the internal inconsistencies of the patent specifications, we construe claim 1, with its additional limitations, to require partial enablement, whereas claim 6, with its unqualified language, to require total enablement.

Although the district court erred in its construction of claim 1 so as to require total enablement of the receiving circuit, we conclude that it was harmless error in light of our earlier conclusion that none of the Code Alert products could be found to infringe claim 1. On the other hand, even though the district court's construction of the enablement limitation was proper with respect to claim 6, we must still decide whether its subsequent determination of noninfringement as to that claim was correct.

There is no dispute that in all of the Code Alert products, the circuitry preceding the microprocessor can

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[2] In its written description, the '155 patent indicates in no less than four passages that the receiving circuit cannot receive signals from the transmitter until the door is open. See '155 patent, col. 1, lines 55-58; col. 3, lines 52-55; col. 4, lines 39-44; col. 8, lines 14-16. Hence, the textual language of the written description indicates that the device is unable to receive signals without it being first enabled.

continuously receive signals. See Senior Tech, 58 F. Supp. 2d at 1083 ("The receive antenna and receiver continuously receive signals and the microprocessor continuously analyzes received signals to determine if a valid signal from a transmitter is received and if a monitored door is open."). Hence, the structure in the accused products corresponding to the "receiving circuit" in the '155 patent does not have to be "enabled," as claim 6 requires, in order to receive transmitted signals. Therefore, it cannot be said that the district court committed clear error when it concluded that the CA9000, along with the rest of the Code Alert products, did not infringe Claim 6, either literally or under the doctrine of equivalents. Therefore, we affirm the district court's conclusion of noninfringement of claim 6 with respect to the remaining Code Alert product, the CA9000.

III

With respect to the cross-appeal issues, R.F. Tech challenges the district court's conclusion on the issues of claim definiteness, invalidity, inequitable conduct, and attorneys' fees.

A

R.F. Tech's claim definiteness argument is based on the fact that the specification appears to contain some internal inconsistencies. Whether the claim definiteness requirement is met in a particular patent is freely reviewable on appeal as a question of law. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). As discussed above, we have resolved the

inconsistencies by pointing out the different requirements of the respective "enablement" limitations in claims 1 and 6. Therefore, as a matter of law, we hold that the specification does not fail to satisfy the claim definiteness requirement as codified in 35 U.S.C. § 112, ¶ 2 (1994).

B

R.F. Tech also challenges the district court's finding that it failed to prove by clear and convincing evidence that the '155 patent was invalid pursuant to 35 U.S.C. § 102(b) (1994).

Pursuant to 35 U.S.C. § 102(b), an inventor is not entitled to patent his invention if it is described in a printed publication, is placed in public use, or is on sale in the United States more than one year prior to the date of application for the patent. Whether an invention was described in a printed publication, in public use, or on sale within the meaning of section 102(b) is a question of law that this court reviews de novo. See Manville Sales Corp. v. Paramount Sys., Inc., 917 F.2d 544, 549, 16 USPQ2d 1587, 1591 (Fed. Cir. 1990). Factual findings underlying the district court's legal conclusion, on the other hand, are subject to the clearly erroneous standard of review. Fed. R. Civ. P. 52(a). A conclusion that a section 102(b) bar invalidates a patent must be based on clear and convincing evidence, Manville Sales, 917 F.2d at 549, 16 USPQ2d at 1591, and must be drawn in light of the "totality of the circumstances." Id. at 549, 16 USPQ2d at 1591; Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1266, 229 USPQ 805, 808 (Fed. Cir. 1986).

The printed publication at issue is a St. Louis Post-

Dispatch article, published on July 5, 1984, generally describing an early high frequency prototype system that was installed in a nursing facility. According to the article, "[a] wristwatch-size radio transmitter is fixed to the patient's arm or leg. When the patient approaches a door, the transmitter's signal is picked up by a special receiver attached to the door. When the door is opened, an alarm is sounding in a nursing station . . . ." Senior Tech, 58 F. Supp. 2d at 1085. The article does no more than give a general description of the basic functionality of a wanderer system. We discern no error in the district court's finding "that the Post-Dispatch article does not sufficiently describe the system such that a person of ordinary skill could devise the invention without undue experimentation." Senior Tech, 58 F. Supp. 2d at 1093.

The district court also determined in its findings of fact that the inventor "did not add a door switch to his invention until March or April of 1985." Id. at 1086. Although there was conflicting testimony from the parties' witnesses, we cannot say that the district court clearly erred in its finding. Given that door switches were not added until March or April of 1985, the prototype systems that were installed in nursing homes prior to the critical date lacked door switches. Therefore, the invention disclosed by the '155 patent was not in public use nor on sale pursuant to section 102(b).

C

R.F. Tech likewise challenges the district court's finding that it failed to establish inequitable conduct with regard to the prosecution of the '155 patent.

At issue is the patentee's failure to disclose two potential prior art references: (1) the St. Louis Post-

Dispatch article, dated July 5, 1984, which reported the success of a prototype system in a field test, and (2) the fact that early versions of the claimed invention were installed in two nursing homes prior to the critical date of January 13, 1985.

It is inequitable conduct to withhold material information from a patent examiner or to submit false material information with the intent to deceive or mislead the examiner into granting a patent. Molins PLC v. Textron, Inc., 48 F.3d 1172, 1178, 33 USPQ2d 1823, 1826 (Fed. Cir. 1995). Inequitable conduct is an equitable issue committed to the discretion of the district court. Therefore, we review the district court's determination for abuse of discretion. See Elk Corp. v. GAF Bldg. Materials Corp., 168 F.3d 28, 30, 49 USPQ2d 1853, 1855 (Fed. Cir. 1999). The determination of inequitable conduct requires a two-step analysis. The first step requires the trial court to determine (1) whether the withheld reference meets a threshold level of materiality, and (2) whether the evidence shows a threshold level of intent to mislead the PTO. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1327, 47 USPQ2d 1225, 1228-29 (Fed. Cir. 1998); Halliburton Co. v. Schlumberger Tech. Corp., 925 F.2d 1435, 1439, 17 USPQ2d 1834, 1838 (Fed. Cir. 1991). These threshold issues must be proven by clear and convincing evidence, and the district court's determinations concerning them are reviewed under the clearly erroneous standard and will not be disturbed unless this court has a "definite and firm conviction that a mistake has been committed." Elk Corp., 168 F.3d at 30, 49 USPQ2d at 1855; see also Kingsdown Med. Consultants, Ltd. v. Hollister, Inc., 863 F.2d 867, 872, 9 USPQ2d 1384, 1389 (Fed. Cir. 1988) (en banc).

The district court determined that both references met the required threshold level of materiality. However, it concluded that the inventor had no intent to deceive the PTO because it was "unclear that [the inventor] knew about the existence of the newspaper article during the pendency of the patent application, or even if he did, that he appreciated its potential significance." Senior Technologies, Inc., 58 F. Supp. 2d at 1086. R.F. Tech offers as evidence the inventor's knowledge of the existence of prior systems based on having installed them and urges us to find intent based on the materiality of the omissions. Since "'[i]nequitable conduct' is not, or should not be, a magic incantation to be asserted against every patentee," nor is an "allegation established upon a mere showing that art or information having some degree of materiality was not disclosed," FMC Corp. v. Manitowoc Co., 835 F.2d 1411, 1415, 5 USPQ2d 1112, 1115 (Fed. Cir. 1987), we do not find that the evidence offered by R.F. Tech is sufficient to conclude that the district court abused its discretion in finding no inequitable conduct.

D

R.F. Tech's last contention relates to the award of reasonable attorneys' fees under 35 U.S.C. § 285 (1994). The prevailing party must prove the existence of an "exceptional" case by clear and convincing evidence under section 285, a question of fact that we review under the clearly erroneous standard. See Hoffmann-La Roche Inc. v. Invamed Inc., 213 F.3d 1359, 1365, 54 USPQ2d 1846, 1850 (Fed. Cir. 2000). We find, as did the district court, that R.F. Tech has not offered sufficient evidence to persuade us that we are dealing with an "exceptional" case that would warrant the award of reasonable attorneys' fees.

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COSTS

No costs.

APPENDIX B

United States Court of Appeals for the Federal Circuit

00-1089, -1090

SENIOR TECHNOLOGIES, INC.,

Plaintiff-Appellant,

v.

R.F. TECHNOLOGIES, INC.,

Defendant-Cross Appellant.

JUDGMENT

ON APPEAL from the UNITED STATES DISTRICT COURT, DISTRICT OF NEBRASKA

in CASE NO(S). 97-CV-3241

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED

ENTERED BY ORDER OF THE COURT

DATED March 12, 2001

s/Jan Horbaly
Jan Horbaly, Clerk

ISSUED AS A MANDATE: April 12, 2001

A True Copy.

Attest: 4-12-01

s/A. M. Tomlinson
Deputy Clerk

APPENDIX C

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEBRASKA

No. 4:97CV3241

SENIOR TECHNOLOGIES, INC.,

Plaintiff,

vs.

R.F. TECHNOLOGIES, INC.,

Defendant.

Decided: July 26, 1999
Richard G. Kopf, United States District Judge

FINDINGS OF FACT AND CONCLUSIONS OF LAW

This is a patent infringement suit in which Plaintiff claims Defendant has infringed two of its patents, the " '155 Patent" and the " '670 Patent."[1] Defendant claims the '155 Patent is invalid under 35 U.S.C. § 102, and that both the '155 and '670 Patents are unenforceable

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[1] These numbers refer to U.S. Patent No. 4,682,155 ('155 Patent) and U.S. Patent No. 5,268,670 ('670 Patent).

due to inequitable conduct before the U.S. Patent and Trademark Office. (Filing 250, Order on Final Pretrial Conference, at 7-8.) I now issue my findings of fact and conclusions of law pursuant to Fed. R. Civ. P. 52(a).[2]

I. FINDINGS OF FACT

1. The products at issue in this case relate to patient or resident departure monitoring systems, also known as wanderer monitoring systems. Wanderer monitoring systems are used in nursing homes, hospitals, assisted living centers, and other care facilities to monitor patients or residents who have a tendency to wander due to Alzheimer's Disease or other forms of dementia. The products are used in health care facilities, particularly in nursing homes, to provide an alarm when a resident attempts to leave the facilities, thereby alerting the staff so the resident can be located and returned to the facility. (Tr. 86-90.)

2. The Plaintiff, Senior Technologies, Inc. ("STI"), is a Nebraska corporation engaged in the manufacture and sale of the "WanderGuard" wanderer monitoring system. (Filing 250, Order on Final Pretrial Conference, at 2; Tr. 288, 300-301.)

3. The Defendant, R.F. Technologies, Inc. ("RFT"), is a Wisconsin corporation engaged in the business of designing, engineering, manufacturing, and selling a

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[2] Any findings of fact more appropriately characterized as conclusions of law shall be so construed, and any conclusions of law more properly deemed findings of fact shall be so construed.

variety of medical working equipment, including wanderer monitoring systems which it sells under the trademark "Code Alert." (Filing 250, Order on Final Pretrial Conference, at 2; Tr. 946-47.) The RFT products at issue following this court's ruling on Defendant's motion for judgment as a matter of law[3] are the CA600, CA9000, CA9100, and the CA9120. (Tr. 921-940.)

A. The Patents and Pertinent Prosecution History

4. John Shirley is the named inventor of U.S. Patent No. 4,682,155 (the " '155 Patent"). (Ex. 1.) STI acquired rights to, and ultimately ownership of, the '155 Patent through a series of licenses and assignments. (Exs. 34, 63, 217; Tr. 143-44, 146-52, 301-04, 307, 311-12.) John Brasch and Alan Cross are the named inventors of U.S. Patent No. 5,268,670 (the " '670 Patent"). (Ex. 54.) STI acquired ownership of the '670 Patent pursuant to an assignment from the inventors. (Ex. 59 at Bates No. 771618.)

5. The '155 Patent has two independent claims: Claims 1 and 6. Claim 1 discloses:

A security sensing system for monitoring the passage of persons through a door or like opening comprising:

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[3] The court explained in detail its findings and conclusions related to Defendant's motion for judgment as a matter of law on a number of Code Alert systems about which no witnesses offered testimony. (Tr. 921-940.) The court found insufficient evidence on the record to enable it to conclude that Plaintiff established a case of infringement as to the devices dismissed.

a transmitter module for installing on persons to be monitored, a sensing module for installing adjacent to a door opening to be monitored, and *means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response*, and alarm means energizable in response to the production of the output response to produce an alarm condition,

the transmitter module including a housing having a transmitter circuit, a source of power for the transmitter circuit and transmitter antenna means installed therein,

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and

said means responsive to the opening of the door including *means to enable the receiving circuit in the sensing module whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response for energizing the alarm means.*

(Ex. 1 (emphasis added).)

6. At issue in Claim 1 of the '155 Patent (as noted above by the italicized language) is whether the RFT CA9000, CA9100, CA9120, and CA600 have (1) a "means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response"; (2) a "sensing module including a receiving circuit and associated sensing means located adjacent

to the door opening to be monitored"; and (3) a "means to enable the receiving circuit in the sensing module whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response for energizing the alarm means." (Tr. 1429-1434; Ex. 509.)

7. Claim 6 of the '155 Patent discloses:

Means to monitor a doorway of a nursing home or other institution in order to produce an alarm when certain residents try to pass therethrough comprising

a transmitter device including a mounting band therefor to be worn on the wrist of the residents to be monitored, said transmitter device having a housing with a modulating circuit, a transmitter radiator and a battery source located therein,

a receiving device for mounting adjacent to the doorway including a housing and a receiving circuit therein, a signal sensor operatively connected to the receiving circuit, means for supplying power to the receiving circuit, *means to enable the receiving circuit*, and an output for the receiving circuit,

an alarm producing device operatively connected to the output of the receiving circuit, and

said means to enable including switch means operatively connected to the receiving circuit, said switch means being mounted in association with the doorway and having a first condition when the doorway is open and a second condition when the doorway is closed, the first condition of the

switch means operating to enable the receiving circuit.

(Ex. 1 (emphasis added).)

8. At issue in Claim 6 of the '155 Patent is whether the RFT CA9000, CA9100, CA9120, and CA600 have (1) a "receiving device for mounting adjacent to the doorway including a housing and a receiving circuit therein"; (2) a "means to enable the receiving circuit"; and (3) "means to enable including switch means operatively connected to the receiving circuit." (Tr. 1435-38; Ex. 509.)

9. During the prosecution history of the '155 Patent, Claims 1 and 6 were amended. Specifically, in the amendment to Claim 1, the applicant added the term "sensing module" and expressly defined it as including the receiving circuit. Likewise, the description of the receiving device mounted adjacent to the doorway in Claim 6 was amended to include "a receiving circuit therein." (Ex. 513, Amendment Dated 1/27/87, at 2-3; Tr. 240-41.)

10. The '670 Patent, which is an improvement to the '155 Patent, has two independent claims: Claims 1 and 6. Claim 1 of the '670 Patent discloses

A method of generating an alert signal comprising the steps of:

generating a first signal when an unauthorized subject is in a first region within seven feet of a monitored passageway;

generating a second signal upon satisfaction of a second condition that indicates the likelihood of

the subject passing through the passageway;

displaying a first indication if the first signal is present and a second indication if the second condition occurs;

the step of generating a first signal including the step of transmitting a signal from the subject to a receiver.

(Ex. 54 (emphasis added).)

11. Claim 6 of the '670 Patent provides:

A security system comprising:

first means for generating a first signal when an unauthorized subject is within seven feet of a passageway;

second means for generating a second signal upon satisfaction of a second condition that indicates the likelihood of the subject passing through the passageway; and

third means for displaying a first indication if the first signal is generated and for displaying a second indication upon the generating of the second signal;

said first means for generating a first signal including means for transmitting a signal from the subject to a receiver.

(Ex. 54 (emphasis added).)

12. At issue is whether the signal light on the face of the control unit for the CA9120 and CA600 meets the above italicized elements of Claims 1 and 6. (Tr. 1453-1458.) STI also accused the CA9100 of having a signal light on the face of the control unit. However, as demonstrated at trial, the CA9100 does not have a signal light on the face of the control unit. (Tr. 1455.)

13. During the prosecution history of the '670 Patent, the claims were originally rejected over prior art. (Tr. 1449; Ex. 59.) To distinguish the prior art, the applicant's attorney argued that the claimed combination in Claims 1 and 6 "permits a nurse monitoring a central station to be alerted to a wanderer about to leave without being unduly alarmed by other circumstances." (Tr. 1453; Ex. 59, Amendment Dated 1/18/93, at 7.)

B. Operation of the '155 Device

14. Claims 1 and 6 of the '155 Patent disclose a personnel monitoring device which includes a transmitter, a sensing module mounted adjacent to the door, a means to enable the receiving circuit in the sensing module, and an alarm means. (Ex. 1, col. 8, ll. 60-68; col. 9, ll. 34-46.)

15. The receiving circuit disclosed in the '155 Patent which is located in the sensing module consists of the AM radio, signal limiter, tone decoder, initial power turn-on delay, low-frequency filter, output stage, and

lead 67. (Ex. 1, Fig. 3; Tr. 1271-73.) In Fig. 4[4], the receiver extends to the left of the point where resistor 136, diode 138, and the unnumbered relay contact directly above the connect. (Ex. 1, Fig. 4; Tr. 1271-73.) The principal function of the receiving circuit 14 is to accept an input signal received from the wanderer's transmitter, process its signal in the successive stages of the receiver, and deliver that signal through the transistor 112 to an output stage to produce a response to energize the alarm. (Tr. 1278.) The function of the two-stage audio filter in Fig. 4 is to extract from noise a single frequency tone between 770 to 990 Hz. (Tr. 2008.) One stage removes components at frequencies less than 770 Hz, while the other stage removes components at frequencies above 990 Hz. (Tr. 2008-09.) The two-stage audio filter simply looks for a single sinusoid 900 Hz wave. (Tr. 2014.)

16. When the door is closed, the input circuit to the transistor 112 is short-circuited and that short circuit has two effects; it disconnects the base of the transistor to the emitter of transistor 112 and it short-circuits the output of the two-stage audio filter 106 through resistor 108, thereby electronically disrupting and disabling the receiving circuit by disconnecting part of the receiving circuit from the remainder of the receiving circuit. (Tr. 1276-77; Ex. 1, col. 8, ll. 19-23; Ex. 63[illegible].) The door switch electrically disconnects the left-hand part of the receiving circuit from the right-hand part of the receiving circuit. (Tr. 2006.) While the left hand is still operating, the right hand is inoperable, or disabled. (Tr. 1278.) The transistor 112 can receive no signal when the door is

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[4] Figure 4 of the '155 Patent is attached to these Findings of Fact and Conclusions of Law.

closed. (Tr. 1278-1279.)

C. Operation of the '670 Device

17. Claims 1 and 6 of the '670 Patent disclose a pre-alert device which displays a light and alarms when a wanderer is within seven feet of a monitored door when the door is closed to give caregivers at a monitoring station warning of a possible departure. (Ex. 54; Tr. 557-58, 1453.)

D. Operation of RFT's Code Alert Products

18. In 1992 RFT first manufactured and sold its CA9000 wanderer monitoring device. The CA9000 consists of a transmitter and receive antennae which are mounted adjacent to a door, a control unit which includes a receiving circuit and a microprocessor that analyzes the signals, and a door switch. (Tr. 1135-44.) The transmitter operates at a frequency of 65.5 Khz and sends an eight-bit coded signal which is detected by a receive antenna mounted near the door. (Tr. 1137-38.) The signal is sent to the receiver in the control unit where it is demodulated and then sent to the microprocessor. (Tr. 1142.) The receive antenna and receiver continuously receive signals and the microprocessor continuously analyzes received signals to determine if a valid signal from a transmitter is received and if a monitored door is open. (Tr. 1143-44.) If the microprocessor determines that it has received an eight-bit coded signal at 65.5 Khz, it then checks to see if the door is open. (Tr. 1143-44.) If the door is open, the microprocessor activates an alarm. (Tr. 1144.)

19. In 1994 RFT introduced the CA9100. Beginning with this model, RFT removed the receiver from the control unit and placed it in the antenna mounted near the door. (Tr. 1151.) Inside both the receiver and the control unit are lights which illuminate upon the detection of "noise," meaning other RF signals that can interfere with the operation of the system. (Tr. 1152.)

20. In 1995 RFT introduced the CA9120, a model which included a modified control unit with an amber signal light on its face. (Tr. 1013.) The amber signal light serves a diagnostic purpose and takes the place of an oscilloscope.[5] The amber signal light flickers if noise is present or a transmitter is within range, advising of the necessity to adjust the system. However, the flickering signal light is not discernable from any appreciable distance, and noise or a transmitter within range would not create a display at a nurse's station. (Tr. 1034-35; 1455.) Before 1996, the signal light was inside the control unit, requiring maintenance persons to remove the cover periodically to check the light for noise. (Tr. 1152-56.)

21. The CA600, which also has the exposed signal light, was introduced in 1998 to be a value alternative to the CA9120. (Tr. 1013, 1037.)

E. Contrast Between Patented Devices and Code Alert Products

22. The door switch (the means responsive to the

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[5] An oscilloscope is an instrument that allows one to view the time and amplitude of electronic signals. (Tr. 1156).

opening of the door) in RFT's Code Alert products is connected to the microprocessor, not the receiving circuit. (Tr. 1283-84.) The control unit, which contains the microprocessor, is a separate module not found in the system described in the '155 Patent and should be located at a distance of 10 feet from the door opening. (Ex. 635B, at 14 & Ex. 635L, at 10.)

23. The door switch is not used in any of the Code Alert devices to enable the sensing module or the receiving circuit to respond to the signal transmitted by the transmitter module to provide an output response or to produce a response for energizing the alarm means. (Tr. 1432, 1434-35.)

24. In contrast to Fig. 4 of the '155 Patent, the door switch in the Code Alert systems is used in conjunction with a resistor and a voltage source to generate a voltage signal. (Tr. 2003.) The signal generated by the door switch in conjunction with the resistor and the voltage source enters the microprocessor on a different terminal than the signal that is generated by the transmitter on the wanderer's wrist. (Tr. 2004.) In contrast, in Fig. 4 of the '155 Patent, the door switch physically connects to the same terminal as the signal coming from the wanderer's transmitter. (Tr. 2004.)

25. The sensing module in the Code Alert products provides an output response to the signal transmitter by the transmitter unit, regardless of whether the door is opened or closed. The Code Alert products use a microprocessor, not a receiving circuit, to respond to the transmitted signals and to send an alarm. (Tr. 1303, 1143-44.)

26. The microprocessor in the Code Alert products

performs AND functions and uses AND gates to perform its functions, including the function of sounding an alarm. (Tr. 2006-07, 2020.) The function of the AND gate in the Code Alert microprocessor is to switch paths within it so that a received input signal is switched through to an output terminal or it is switched somewhere else inside the AND gate. (Tr. 2022.) The transistors in the microprocessor which are connected together to form an AND gate are switches. (Tr. 2005.) By definition, an AND gate is a switch device which steers a signal one way or another, but it does not disconnect the signal. (Tr. 2006-07.) There is no electrical interruption between the AND gate and the transistor. (Tr. 2022.)

27. The AND gate in the Code Alert microprocessor has two independent input signals or voltages, in contrast to transistor 112 in Fig. 4 of the '155 Patent, which has only one input terminal. (Tr. 2006.) A voltage signal is applied at each of the two independent input terminals in the AND gate in the microprocessor. One signal is used to switch a transistor or equivalent within the AND gate so that it transmits or it does not transmit the second input, which would be the signal received from the wanderer's transmitter. (Tr. 2006.)

28. There is no electrical interruption in the Code Alert microprocessor, as there is in the device disclosed in the '155 Patent. In the microprocessor, there is a switching action that occurs that determines whether a received signal will be sent to a transistor or not, but the switching action is controlled by two independent voltage signals entering the AND gate. (Tr. 2021.) In contrast, in Fig. 4 of the '155 Patent, there is only one electrical signal present at any time on the input to transistor 112, and that electrical input signal is

effectively removed from the circuit when the door switch is closed because the door switch short-circuits the current coming rom audio filter 106 through the resistor to the right of it. (Tr. 2021.)

29. The audio filter 106, door switch 168, and transistor 112 in the '155 Patent do not perform an AND function and the transistor 112 is not an AND gate. (Tr. 1270-71.) An AND gate requires two binary inputs to which two binary signals are applied. (Tr. 1266-69.) Transistor 112 is an analog device that has only one input terminal, not two. (Tr. 1270.) Further, the audio filter's output is the input to the transistor 112. Since the audio filter is an analog device, it produces an analog output, not a binary output. (Tr. 1271.) Further, the door switch emits no signal. (Tr. 1284-85, 2021.) Therefore, transistor 112 is not an AND gate because it does not have two binary inputs to which two binary signals are applied. (Tr. 1270-71.) For the controller module in the Code Alert products to be disabled and enabled by the door switch as the receiving circuit in the '155 Patent is, the door switch must be disconnected and reconnected at the microprocessor's input terminal, which receives the signal generated by the transmitter on the wanderer's wrist, so that when the door switch is closed, the signal is short-circuited to ground, thus altering the electric circuit in the Code Alert systems in the same way the receiving circuit shown in Fig. 4 of the '155 Patent is structurally changed by the activation of the door switch. (Tr. 2002-2003.) The effect of this alteration would be to prevent the transmitted signal received from the wanderer from entering the microprocessor, just as the door switch in Fig. 4 prevents the signal from entering transistor 112. (Tr. 2003.)

30. The microprocessor in the Code Alert systems does not substantially perform the functions of the audio filter in Fig. 4 of the '155 Patent. The input signal to the audio filter is an analog signal. The input to the microprocessor is a digital or binary signal. For the Code Alert microprocessor to perform the functions of the audio filter in Fig. 4, two additional components must be added to the microprocessor: first, an analog-to-digital converter to allow conversion of the analog signal at the input of the audio filter to digital form in order to allow the microprocessor to function; and second, a multi-bit input port. (Tr. 2007 & 2009.) Neither device is disclosed in the '155 Patent.

31. The microprocessor in the Code Alert products is not the substantial equivalent of the audio filter 106 and transistor 112 in the '155 Patent for the reasons stated in the above paragraph, and because the hardware and software in the Code Alert products operate differently than the hardware and software that would be required to operate the Code Alert products reconfigured to perform the same functions as the audio filter and transistor in the '155 Patent. (Tr. 2013-17.) Specifically, the hardware of a digital filter would periodically sample the analog input signal. (Tr. 2011-13.) In contrast, the microprocessor in the actual Code Alert products is conducting other business internally, noting the time each burst of carrier is received from the transmitter. (Tr. 2013.) Once the microprocessor receives eight bursts, it examines the times at which those bursts arrived and reaches a decision as to whether those times are correct to qualify as a valid signal. (Tr. 2013.) In terms of software, a digital audio filter takes input samples at intervals of 500 millionths of a second. (Tr. 2016.) In contrast, the Code Alert system takes a sample as each new burst arrives.

F. 35 U.S.C. § 102(b) & Inequitable Conduct

32. John Shirley applied for the '155 Patent on January 13, 1986, making the "critical date" for purposes of invalidity analysis January 13, 1985. (Ex. 1.) In early June 1984, inventor John Shirley, Louis Schrieber, and Sid Martin, all of whom had entered an agreement to manufacture and market a wanderer monitoring system, installed such a system at the Evergreen nursing facility in Creve Coeur, Missouri, for field testing. (Tr. 173-76, 266.) The success of the system was reported in a July 5, 1984, article appearing in the St. Louis Post-Dispatch, which stated: "A wristwatch-size radio transmitter is fixed to the patient's arm or leg. When the patient approaches a door, the transmitter's signal is picked up by a special receiver attached to the door. When the door is opened, an alarm is sounding in a nursing station . . . ." (Ex. 522.)

33. In early to mid-fall of 1984, the wanderer monitoring system was also installed at the Clayton on the Green nursing home in Missouri. The administrator of that facility, Catherine Bono, understood that the facility would not pay for the system, and that adjusting and "testing" of the system were being performed by the product's inventor and his partners, who had permission to enter and leave the facility as they wished in order to perform system adjustments. (Filing 319B, Dep. Catherine Bono, at 8-12, 37; Tr. 266.)

34. Inventor John Shirley did not add a door switch to his invention until March or April of 1985. (Tr. 107-111, 228.) Ms. Bono, administrator of the Clayton on the Green facility, testified that she believed the early units installed at her facility required a door to open for an

alarm to sound. (Filing 319B, Dep. Catherine Bono, at 13-15.) However, Ms. Bono also testified that at times the units alarmed *before* the door opened. (Id. at 41.) Mr. Shirley's testimony and a demonstrative video shown during trial depicted how an early unit lacking a door switch could appear to sound an alarm when the door was opened. (Ex. 35; Tr. 128.) The receiver of the unit had a gain control which could be adjusted so that a person wearing a transmitter did not actually cause an alarm until that person was at or through the door, but creating the appearance that the opening of the door triggered an alarm. (Tr. 128-130.) This evidence weighs heavily against finding that operations like those described in the newspaper article or described by Ms. Bono indicate use of a door switch prior to the critical date. This conclusion is confirmed by Dr. Murphy, the defendant's expert witness, who testified that the circuit of Fig. 4 of the '155 Patent appeared to have been originally designed to operate without a door switch (Tr. 1286), as stated by Mr. Shirley. (Tr. 90, 99-101, 107-112.)

35. Inventor John Shirley did not disclose to the '155 Patent examiner the installation of the early wanderer monitoring systems at the Evergreen and Clayton on the Green nursing homes, or the existence of the July 5, 1984, newspaper article appearing in the St. Louis Post-Dispatch. (Tr. 228-29.) Mr. Shirley's omissions were material because they would have disclosed the existence of a device that was closer to the invention claimed in the '155 Patent than any of the prior art, and a reasonable patent examiner therefore would have wanted to review such information in considering whether to allow the issuance of the patent. (Tr. 1499; Exs. 15, 18, and 19.) However, because it is unclear that Mr. Shirley knew about the existence of the

newspaper article during the pendency of the patent application, or, even if he did, that he appreciated its potential significance, Mr. Shirley had no intent to deceive the U.S. Patent and Trademark Office. (Tr. 228-29.)

II. CONCLUSIONS OF LAW

Plaintiff asserts that the defendant's Code Alert products which remain at issue in this lawsuit infringe Claims 1, 2, 6, and 8 of the '155 Patent and Claims 1 and 6 of the '670 Patent.

A. Literal Patent Infringement

1. One who makes, uses, or sells another's patented invention within the United States is liable for infringement. 35 U.S.C. § § 154, 271(a).

2. STI has the burden of showing infringement by a preponderance of the evidence. Smithkline Diagnostics, Inc. v. Helena Labs. Corp., 859 F.2d 878, 889 (Fed. Cir. 1988); Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 758 (Fed. Cir. 1984).

3. Literal infringement requires a two-step analysis: "(1) a proper construction of the claim to determine its scope and meaning, and (2) a comparison of the properly construed claim to the accused device or process." Conroy v. Reebok Int'l Ltd., 14 F.3d 1570, 1572 (Fed. Cir. 1994); Dolly, Inc. v. Spalding & Evenflo Companies, Inc., 16 F.3d 394, 397 (Fed. Cir. 1994). The first step is a question of law; the second is a question of fact. Standard Oil Co. v. American Cyanamid Co.,

774 F.2d 448, 452 (Fed. Cir. 1985). The first step requires the court to look at the claim language, the patent's specification, and the prosecution history. Arachnid, Inc. v. Medalist Mktg. Corp., 972 F.2d 1300, 1302 (Fed. Cir. 1992).

4. A product literally infringes a patent if each of the limitations in the asserted patent claim is contained in the accused product. North American Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571, 1574 (Fed. Cir. 1993), cert. denied, 511 U.S. 1069 (1994). For infringement to exist, every limitation in a patent claim must be met exactly or by a substantial equivalent. Becton Dickinson & Co. v. C.R. Bard, Inc., 922 F.2d 792, 796 (Fed. Cir. 1990); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1054 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

5. "One who does not infringe an independent claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim." Wahpeton Canvas Co., Inc. v. Frontier, Inc., 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989).

6. 35 U.S.C. § 112(6) applies in analyzing literal infringement where there is means-plus-function claim. language. This section provides: "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." "In order to meet a means-plus-function limitation, an accused device must (1) perform the identical function recited in the means limitation and (2) perform that function using the

structure disclosed in the specification or an equivalent structure." Kearns v. Chrysler Corp., 32 F.3d 1541, 1548 n.8 (Fed. Cir. 1994), cert. denied, 514 U.S. 1032 (1995).

7. "In the context of section 112 . . . an equivalent results from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification. A determination of section 112 equivalence does not involve the equitable tripartite test of the doctrine of equivalents. As this court has stated, the sole question under section 112 involves comparison of the structure in the accused device which performs the claimed function to the structure in the specification." Valmont Industries, Inc. v. Reinke Mfg. Co., Inc., 983 F.2d 1039, 1043 (Fed. Cir. 1993) (internal punctuation and citations omitted).

8. "Generally, a number of factors may be considered when determining the scope of a means-plus-function limitation, including the language of the claim, the patent specification, the prosecution history of the patent, other claims in the patent, and expert testimony." In re Hayes Microcomputer Products, Inc. Patent Litigation, 982 F.2d 1527, 1543 (Fed. Cir. 1992) (internal punctuation and citation omitted).

1. Claim Construction

9. Claims are construed based on the actual claim language, the specification, the file history, and, if necessary, extrinsic evidence. Markman v. Westview Instruments, Inc., 52 F.3d 967, 979-80 (Fed. Cir. 1995), aff'd, 517 U.S. 370 (1996). The standard applied is what one reasonably skilled in the art at the time of the

invention would have understood the term to mean. Id. at 986. The claims establish the limits or boundaries of the patent while the specification, of which the claims are a part, contains a written description of the invention that would enable one of ordinary skill in the art to make or use the invention. Claims must be read in view of the specification of which they are a part. Id. at 979. "For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims." Id. Looking to a patent's specification to aid a court's interpretation of a term in a claim is an appropriate practice. Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 93 F.3d 1572, 1578 (Fed. Cir. 1996).

10. Likewise, the Court has bond power to look as a matter of law to the prosecution history of the patent in order to ascertain the true meaning of language used in patent claims. Markman, 52 F.3d at 979. The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution. Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed. Cir.), cert. denied, 516 U.S. 987 (1995).

11. Claims 1 and 6 of the '155 Patent present two claim construction issues: (1) whether the claims disclose a sensing module which must be mounted adjacent to the door and which must include both the antenna and the receiving circuit that receives signals and responds to those signals to produce an alarm, and (2) whether "means to enable the receiving circuit" discloses a receiving circuit capable of receiving signals from the transmitter when the door is open, but incapable of receiving signals when the door is closed.

12. With regard to the first issue, in the amendment to Claim 1, the applicant added the term "sensing module" and expressly defined it as including the receiving circuit. Likewise, the description of the receiving device mounted adjacent to the doorway in Claim 6 was amended to include "a receiving circuit therein." In the prior art section of the '155 Patent, the "receiver unit" and "receiver module" are identified as being "located on or adjacent to the door or doorway." (Ex. 1, col. 1, ll. 56-57; col. 2, ll. 6-7.) The specification includes similar references. (Ex. 1, col. 6, ll. 43-47.) "Receiver" and "sensing module" are used interchangeably in the specification. (Ex. 1, col. 3, l. 54; col. 4, l. 27, l 43; col. 5, ll. 60-61; col. 6, ll. 58-59.) Based on the amendments and definitions given in the '155 Patent, the sensing module disclosed in the claims requires that the receiving circuit which responds to the signals and produces a response be inside of the sensing module, and the sensing module be mounted adjacent to the door.

13. The specification, likewise, defines the term "enable." At col. 8, ll. 13-16, the '155 Patent states: "When the door is closed the receiver circuit is incapable of receiving signals from the transmitters but when the door is open it can receive such signals." (Emphasis added, numerical references omitted.) At col. 8, ll. 19-22, the patent describes how the receiving circuit is disabled: "When the door is closed, the switch 168 (see also FIG. 4) is not actuated (closed) and will short between the base and the emitter of the transistor 112. This prevents the transistor 112 from energizing the relay 124." Also at col. 4 the specification states:

> It should be noted that with the present system a resident equipped with a transmitter module can

> move as he or she wants to an unauthorized door so long as the door is not opened without the receiver module being enabled to receive the transmitted signal. In other words there must be some movement of a door member to operate switch means in the circuit of the receiver before the receiver will be able to receive a signal and produce a response for sending to the nurse's station. If some door movement were not required then every time a resident equipped with a transmitter module 10 came close to a door a signal would be received and a response sent and this would be undesirable.

(Emphasis added). In addition, at col. 1, ll. 55-58, the prior art is distinguished over the invention and the transmitter modules are described as "continuously transmit[ing] omnidirectional signals that are received by a receiver unit located on or adjacent to the door or doorway, but only when the door is opened by a person so equipped."

14. Based on the language in the specification of the '155 Patent, the court concludes that Claims 1 and 6 of the '155 Patent disclose a receiving circuit that can receive signals when the door is open, but cannot when the door is closed. The receiving circuit is enabled by the door switch when the door is open and disabled by the door switch when the door is closed.

15. The issue raised by Claims 1 and 6 of the '670 Patent is the location of the first display which serves as the pre-alert. The prosecution history, however, resolves the issue. Claims 1 and 6 of the original application for the '670 Patent were rejected as obvious over prior art. In order to distinguish the prior art, the applicant's attorney argued that the claimed combination "permits

a nurse monitoring a central station to be alerted to a wanderer about to leave without being unduly alarmed by other circumstances." (Ex. 516, at 7.) The claims were then allowed. By virtue of this argument, this patentee relinquished any right to a device that may display a first indication at a location other than a central monitoring station. This conclusion is consistent with the specification which states, "an alert signal is given by the first signal means on the monitoring station. Thus, persons at the central station will pay close attention waiting for an alarm signal." (Ex. 54, col. 5, ll. 56-59 (numerical references omitted).)

16. Based on the prosecution history of the '670 Patent, Claims 1 and 6 of the '670 Patent disclose a pre-alert display which displays a light at a remote location when a monitored person wearing a transmitter is within seven feet of the monitored door when the door is closed in order to give a caregiver advance notice that a monitored person may open the door and leave.

2. Literal Infringement Analysis

a. The '155 Patent

17. As stated above, Claims 1 and 6 are written in "means-plus-function" format. Such claims are "construed to cover the corresponding structure, . . . described in the specification and equivalents thereof." 35 U.S.C. § 112(6). To find literal infringement, the fact finder must determine whether the accused device performs an identical function to the one recited in the means-plus-function clause. If the identical function is performed, the fact finder then determines whether the accused device utilizes the same structure or materials

described in the specification or their equivalents. Mas-Hamilton Group v. LaGard, Inc., 156 F.3d 1206, 1211-12 (Fed. Cir. 1998).

18. The door switch (the means responsive to the opening of the door) is not used in any of the four Code Alert devices at issue to enable the sensing module or the receiving circuit to respond to the signal transmitted by the transmitter module to provide an output response or to produce a response for energizing the alarm means. (Tr. 1312-14, 1434-35.) Rather, the sensing module in the accused products provides an output response to the signal transmitted by the transmitter unit, whether the door is open or closed. (Tr. 1303.) In addition, the door switch is utilized in cooperation with a separate control module, not found in the system described in the '155 Patent, which may be located at an arbitrary distance from the door opening. (Tr. 1430-32.) Therefore, the accused products do not have a sensing module with the components described in the claim located adjacent to the door, and the sensing module in the Code Alert products which is adjacent to the door does not perform the claimed functions. Further, in the CA9000, only an antenna, not the receiver, is adjacent to the door. (Tr. 1303, 1313.) Since the door switch does not perform the identical function recited in the means-plus-function clauses, the Code Alert systems cannot infringe. Further, the Code Art control unit is not the same or equivalent to the receiver disclosed in the patent. Because not all elements of Claim 1 of the '155 Patent are present in the accused device, the CA9000, 9100, 9120, and 600 products do not literally infringe Claim 1.

19. Likewise, the CA9000, 9100, 9120, and 600 do not literally infringe Claim 6 because (1) the receiving

circuit which responds to signals to produce a response is not contained in the housing of the sensing module and (2) the door switch is connected to the control module, not the receiving circuit, and the door switch functions to provide a signal to a computing unit, not to enable the receiving circuit. (Tr. 1316-17, 1436-37.) Again, the door switch does not perform the identical function, and the control unit is not the same or equivalent to the receiver disclosed in the '155 Patent. Therefore, these devices do not literally infringe since not all elements are present in the accused devices.

20. Simply put, I conclude that there is no literal infringement of the '155 Patent because the patent refers to "enabling" the circuit to receive a signal, such that no portion of the transmitter signal is received by the transistor that activates the alarm when the door is closed due to an electrical block between the transistor and the audio filter. This is in contrast to the Code Alert products' microprocessor, in which the transistor that fires the relay that activates the alarm receives a portion of the digital signal when the door is closed. Thus, the patented and accused products are literally different. This conclusion is consistent with General Elec. Co. v. Nintendo Co., Ltd., 1999 WL 357623 **3-4 (Fed. Cir. June 2, 1999), in which the court, interpreting a means-plus-function claim, found that disruption of a signal path in the patented invention was not the same as bypassing the signal path, as in the accused system. In the '155 Patent, the signal path is electronically disrupted by the door switch. In the accused products, the microprocessor switches signals from path to another. As in General Electric, identical functions are not performed.

21. The court further finds no literal infringement of

dependent Claims 2 and 8 of the '155 Patent.

b. The '670 Patent

22. The CA9120 and CA600 do not literally infringe Claims 1 or 6 the '670 Patent because the signal light displayed on the face of the control unit does not constitute a first indication displayed at a nurse's station when an unauthorized subject is in a first region within seven feet of a monitored passageway. (Tr. 1333, 1454-56, 1458-59.) The CA9120 and 600 devices produce an indication at the nurse's station only when the door is open. Therefore, not all elements are literally present in the accused devices. Because neither the CA9000 nor the CA9100 have a status light on the outside of their control units, these products do not literally infringe the '670 Patent.

B. Patent Infringement Under the Doctrine of Equivalents

23. A device may infringe under the doctrine of equivalents if it is demonstrated that each and every element or limitation of a claim is present in the accused device by a substantial equivalent which performs substantially the same function in substantially the same way to reach substantially the same result. Augustine Medical, Inc. v. Gaymar Indus., Inc., 1999 WL 371740, at *12 (Fed. Cir. June 8, 1999).

24. The doctrine of equivalents is not a license to erase or ignore the structural or functional limitations of a patent claim on which the public is entitled to rely in avoiding infringement. Athletic Alternatives, Inc. v.

Prince Mfg., Inc., 73 F.3d 1573, 1581-82 (Fed. Cir. 1996). The doctrine of equivalents should not be employed to rewrite claims. See London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1538 (Fed. Cir. 1991).

1. The '155 Patent

25. The accused products use a microprocessor, not a receiving circuit, to respond to signals and send an alarm. The sensing module in the accused devices outputs the signal received from the transmitter at all times, whether the door is open or closed. This output signal is processed in the microprocessor, which checks to see whether the door is open or not after verifying that a valid eight-bit coded signal at 65.5 Khz has been received. If so, the microprocessor activates the alarm, thus the microprocessor is used to perform elaborate signal processing not disclosed in the patent, and not as a receiving circuit. The microprocessor processes signals whether the door is open or not.

26. To establish that RFT's microprocessor is a substantial equivalent of the '155 receiving circuit, STI makes two arguments. First, STI argues the audio filter 106, door switch 168, and transistor 112 of the '155 Patent perform an AND function and that transistor 112 is an AND gate, just as the microprocessor in the Code Alert system performs AND functions and uses AND gates to perform its functions, including the function of sounding an alarm. (Tr. 502-03.) STI's argument fails for several reasons. First an AND gate requires two binary inputs to which two binary signals are applied. Transistor 112 has only one input terminals, not two. (Tr. 1270.) Second, the audio filter's output is the input to transistor 112. Yet the audio filter is an analog device

which products an analog, not binary, output. (Tr. 1271.) Further, the door switch in the '155 Patent emits no signal. Transistor 112 is not an AND gate, because it does not have two binary inputs to which two binary signals are applied. (Tr. 1270.) Therefore, the Code Alert microprocessor and '155 receiving circuit do not function in substantially the same way by substantially the same means.

27. Second, STI argues that Code Alert microprocessor is the substantial equivalent of the audio filter 106 and transistor 112 of Fig. 4 to the '155 Patent. (Tr. 1985-88.) However, STI's argument fails because the Code Alert microprocessor could perform the function of the audio filter only if an analog-to-digital converter were added to the microprocessor. (Tr. 2007-10.) Neither device is disclosed in the '155 Patent. Further, Dr. Murphy's testimony at trial contrasted the different functioning of the hardware and software of the actual Code Alert products versus the functioning of the Code Alert products if they were converted to perform the functions of the audio filter and transistor. (Tr. 2009-2017.)

28. In essence, the way in which the Code Alert system operates is much different than the operation of the plaintiff's system. In particular the digital code that Plaintiff says is equivalent to the analog tone is materially different because it is less likely to trigger a false alarm. An analog signal, like the transmitter signal in the plaintiff's device, can exist as interference coming from another source, causing the false alarm. That same condition is substantially less likely to occur with a digital signal. Thus, the Code Alert system does not perform in substantially the same way because the inherent differences between analog signals and digital

signals provide an inherently different product that results not from mere improvements to the plaintiff's systems, but from inherent changes in the type of signal that generates the alarm. Here, the focus is on the type of signal that generates the alarm and the type of receiver necessary to process the signal, and both the signal and the equipment that process the signal are inherently different and perform in substantially different ways. Therefore, the CA9000, 9100, 9120, and 600 do not infringe Claims 1 or 6 of the '155 Patent under the doctrine of equivalents because they do not function in substantially the same way by using substantially the same means.

29. Again, as in General Elec. Co. v. Nintendo Co., Ltd., the receiving circuit and microprocessor do not perform equivalent functions. Id., 1999 WL 357623, at *5.

2. The '670 Patent

30. The CA9120 and CA600 do not infringe Claims 1 or 6 of the '670 Patent under the doctrine of equivalents because the signal light in the Code Alert products does not perform substantially the same function of displaying an alert at a central location that warns when a monitored person is within seven feet of a monitored passageway. (Tr. 1487-89.) Specifically, if a wanderer is near the door, the flickering yellow light at the box near the door in the Code Alert products does not serve substantially the same function as the constant red alert on the nurses' panel in Plaintiff's product.

31. Since neither the CA9000 nor CA9100 have a

signal light on the face of the control unit, neither device infringes the '670 Patent under the doctrine of equivalents.

C. Patent Validity

1. 35 U.S.C. § 102(b)

32. A patent is presumed valid and the party asserting invalidity must overcome the presumption by clear and convincing evidence establishing facts which support the conclusion of invalidity. 35 U.S.C. § 282; Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n, 988 F.2d 1165, 1177 (Fed. Cir. 1993).

33. Under 35 U.S.C. § 102(b), an inventor loses the right to obtain a patent if the invention is the subject of a printed publication, is placed in public use, or is on sale in the United States more than one year prior to the date of the application for the patent.

34. To be considered a § 102(b) reference, the item must sufficiently describe the claimed invention to have placed the public in possession of it. Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 804 F.2d 659, 665 (Fed. Cir. 1986); Carella v. Starlight Archery & Pro Line Co., 804 F.2d 135, 139 (Fed. Cir. 1986). The disclosure must be such as will give possession of the invention to the person of ordinary skill. Paperless Accounting, Inc., 804 F.2d at 665. See Struthers Scientific & Int'l Corp. v. Rappl & Hoenig Co., Inc., 453 F.2d 250, 255 (2d Cir. 1972) (description in printed publication for purposes of 35 U.S.C. § 102(b) must "impart to the person of ordinary skill sufficient information which, coupled with the disclosures of the

prior art, would enable him to devise invention without further genuine inspiration or undue experimentation.").

35. Public use includes "'any use of [the claimed] invention by one who is under no limitation, restriction or obligation of secrecy to the inventor.'" Baxter Int'l, Inc. v. COBE Laboratories, Inc., 88 F.3d 1054, 1058 (Fed. Cir. 1996) (quoting In re Smith, 714 F.2d 1127, 1134 (Fed. Cir. 1983)), but "the existence of a confidentiality agreement is not dispositive of the public use issue." Tone Brothers, Inc. v. Sysco Corp., 28 F.3d 1192, 1200 n.8 (Fed. Cir. 1994), cert. denied, 514 U.S. 1015 (1995). "'The use of an invention by the inventor himself, or of any other person under his direction, by way of experiment and in order to bring the invention to perfection, has never been regarded as [a public] use.'" Baxter Int'l, Inc., 88 F.3d at 1059 (quoting City of Elizabeth v. American Nicholson Pavement Co., 97 U.S. 126, 134 (1877)).

36. "[T]he on-sale bar applies when two conditions are satisfied before the critical date. First, the product must be the subject of a commercial offer for sale. . . . Second, the invention must be ready for patenting." Pfaff v. Wells Electronics, Inc., 119 S. Ct. 304, 311-12 (1998). In Pfaff, the first part of the test was satisfied by a purchase order. Id. at 312. Similarly, the Federal Circuit, applying the Pfaff test, found the on-sale bar test satisfied by record evidence of a signed purchase agreement before the critical date. Weatherchem Corp. v. J.L. Clark, Inc., 163 F.3d 1326, 1333 (Fed. Cir. 1998). Other definitions of what qualifies as clear and convincing evidence of a sale offer include: "a specific and definite offer for sale of a successfully tested device, such as that evidenced by a completed contract for sale, that embodies every limitation of the later patented

invention as claimed prior to the critical date and that sale is clearly for commercial purposes," Evans Cooling Systems, Inc. v. General Motors Corp., 125 F.3d 1448, 1451 (Fed. Cir. 1997), cert. denied, 118 S. Ct. 1050 (1998); "the sale or offer was primarily for profit rather than for experimental purposes," Kolmes v. World Fibers Corp., 107 F.3d 1534, 1540 (Fed. Cir. 1997) (internal punctuation and citation omitted); and "a sale made on ordinary commercial terms," Mahurkar v. Impra Inc., 71 F.3d 1573, 1577 (Fed. Cir. 1995). Inferences of a sale or offer to sell, even if likely, are insufficient to meet clear and convincing burden of proof. Intel Corp. v. U.S. Int'l Trade Comm'n, 946 F.2d 821, 830 (Fed. Cir. 1991).

37. An instructive explanation of what fails to constitute a sale offer was given by the Federal Circuit in overturning an invalidity finding of a district court in Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (internal citations omitted):

> The district court reasoned that this project "called for the eventual marketing of the Marcus bottles once all technical difficulties were resolved," and on this basis held that the Marcus bottles were on sale. This holding was in error, for the "on sale" bar of § 102(b) does not arise simply because the intended customer was participating in development and testing.

38. As in the situation before this Court, making preparations for the sale of a claimed invention does not invoke the on-sale bar without a showing by clear and convincing evidence that an actual sale or definite offer

to sell before the critical date occurred. Intel Corp., 946 F.2d at 830.

39. With regard to the 1984 St. Louis Post-Dispatch article describing the early high frequency prototype system that was installed in the Evergreen nursing home in Missouri as being a publication sufficient to invalidate the '155 Patent under 35 U.S.C. § 102(b), the Court finds that the Post-Dispatch article does not sufficiently describe the system such that a person of ordinary skill could devise the invention without undue experimentation.

40. Installation of the wandering monitoring system at the Missouri nursing homes prior to the critical date for "testing" does not constitute a public use under 35 U.S.C. § 102(b) sufficient to invalidate the '155 Patent. (Tr. 107-11, Test. of John Shirley; Filing 319B, Dep. Catherine Bono, at 37.) Baxter Int'l, Inc., 88 F.3d at 1058-60.

41. The court also finds there is not clear and convincing evidence of an offer or sale of the patented system before the critical date of January 13, 1985. No system in existence prior to the critical date had a door switch or other "means responsive to the opening of the door," which is a necessary element of the claims of the '155 Patent. Further, there was no evidence of a purchase order, amount paid, contract for sale, or sale or offer made primarily for profit. The Court finds that RFT has failed to meet its burden of demonstrating a pre-critical date sale or offer of the patented invention by clear and convincing evidence, and therefore RFT has failed to invalidate the '155 Patent pursuant to 35 U.S.C. § 102(b).

2. Inequitable Conduct

42. The defense of inequitable conduct before the United States Patent and Trademark Office ("PTO"), if proven, renders all the claims of the patent in suit unenforceable for the life of the patent. J.P. Stevens & Co., Inc. v. Lex Tex Ltd., Inc., 747 F.2d 1553, 1560 (Fed. Cir. 1984), cert. denied, 474 U.S. 822 (1985). Establishing the defense of inequitable conduct requires proof by clear and convincing evidence that inequitable conduct by the applicant or those connected with the application occurred during the application process of the patent in question. Both the elements of intent and materiality must be proven by clear and convincing evidence. Braun, Inc. v. Dynamics Corp. of America, 975 F.2d 815, 822 (Fed. Cir. 1992); J.P. Stevens & Co., Inc., 747 F.2d at 1559.

43. Inequitable conduct "includes failure to disclose material information, or submission of false material information." J.P. Stevens & Co., Inc., 747 F.2d at 1559.

44. To be guilty of inequitable conduct, one must have intended to act inequitably. Braun, Inc., 975 F.2d at 822; FMC v. Manitowoc Co., Inc., 835 F.2d 1411, 1415-17 (Fed. Cir. 1987). "A holding of inequitable conduct requires . . . proof of intent to deceive or mislead, and does not flow simply from failure to meet the requirements of patentability. Culpable conduct is required, such as intentional concealment of the best mode under the mask of a fictitious mode." Engel Indus., Inc. v. Lockformer Co., 946 F.2d 1528 (Fed. Cir. 1991) (citations omitted).

45. "[O]ne who alleges a 'failure to disclose' form of inequitable conduct must offer clear and convincing

proof of: (1) prior art or information that is material; (2) knowledge chargeable to applicant of that prior art or information and of its materiality; and (3) failure of the applicant to disclose the art or information resulting from an intent to mislead the PTO. That proof may be rebutted by a showing that: (a) the prior art or information was not material (e.g., because it is less pertinent than or merely cumulative with prior art or information cited to or by the PTO); (b) if the prior art or information was material, a showing that applicant did not know of that art or information; (c) if applicant did know of that art or information, a showing that applicant did not know of its materiality; (d) a showing that applicant's failure to disclose art or information did not result from an intent to mislead the PTO." FMC Corp., 835 F.2d at 1415.

46. Even if the Post-Dispatch article was material, RFT has not shown by clear and convincing evidence that Mr. Shirley, the inventor of the '155 Patent, had any culpable intent in failing to bring the Post-Dispatch newspaper article to the attention of the examiner handling the patent application, or that he appreciated the materiality of the article. Mr. Shirley clearly remembered that the initial units, including the one referred to in the Post-Dispatch newspaper article, were not sold or offered for sale. Moreover, he knew that the units described in the article had no door switches, as did the device he sought to patent. Further, RFT presented no evidence establishing that other persons owing a duty to the Patent Office both were aware of the newspaper article and appreciated its potential significance.

47. RFT has failed to establish inequitable conduct with regard to the prosecution of the '670 Patent as well.

D. Attorneys' Fees

48. The court does not find this case to be "exceptional" within the meaning of 35 U.S.C. § 285 such that an award of reasonable attorneys' fees to the prevailing party is warranted.

III. CONCLUSION

For the reasons discussed above, I conclude that (1) Defendant has not infringed Plaintiff's U.S. Patent No. 4,682,155 or Plaintiff's U.S. Patent No. 5,268,670; (2) U.S. Patent No. 4,682,155 is not invalid under 35 U.S.C. § 102; and (3) RFT has failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patent No. 4,682,155 and U.S. Patent No. 5,268,670 unenforceable.

IT IS ORDERED:

1. Judgment shall be entered against Plaintiff, and in favor of Defendant, on Plaintiff's infringement claims for the reason that Defendant has not infringed Plaintiff's U.S. Patent No. 4,682,155 or Plaintiff's U.S. Patent No. 5,268,670. On Defendant's counterclaims against Plaintiff, judgment shall be entered against Defendant and in favor of Plaintiff for the reasons that U.S. Patent No. 4,682,155 is not invalid under 35 U.S.C. § 102 and RFT has failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patent No. 4,682,155 and U.S. Patent No. 5,268,670 unenforceable.

2. Judgment shall be withheld pending Magistrate Judge Piester's resolution of Plaintiff's application (filing 312) for fees pursuant to Judge Piester's prior order (filing 283).

DATED this 26th day of July, 1999.

BY THE COURT:

s/Richard G. Kopf
Richard G. Kopf
United States District Judge

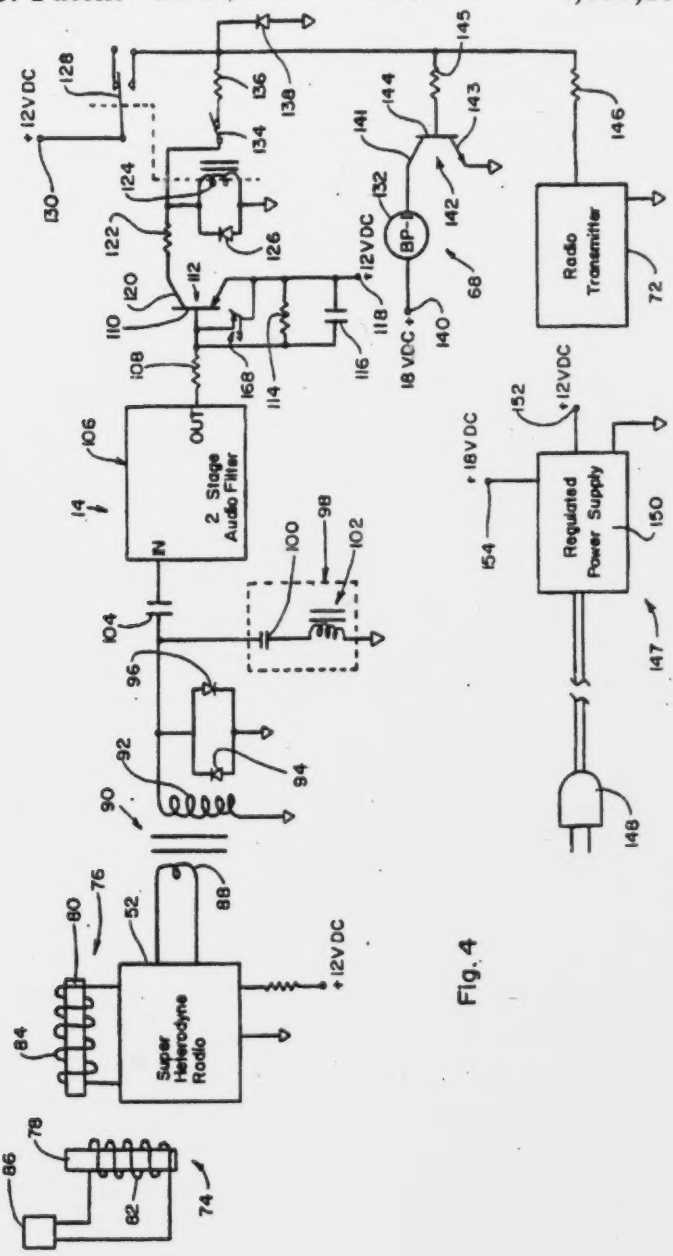

Fig. 4

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APPENDIX D

United States Court of Appeals
for the Federal Circuit

00-1089, -1090

SENIOR TECHNOLOGIES, INC.,

Plaintiff-Appellant,

v.

R.F. TECHNOLOGIES, INC.,

Defendant-Cross Appellant.

Decided: April 5, 2001

ORDER

Before CLEVENGER, Circuit Judge, and BRYSON, Circuit Judge.

A petition for rehearing having been filed by the APPELLANT,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on April 12, 2001.

FOR THE COURT,

s/Jan Horbaly

Jan Horbaly
Clerk

Dated: April 5, 2001

cc: Roger D. Greer
Jane C. Schlicht

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

APR - 5 2001

JAN HORBALY
CLERK

SENIOR TECH V R.F. TECH, 00-1089, -1090
(DCT - 97-CV-3241)

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Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

****

Supreme Court, U.S.
FILED
AUG 13 2001
CLERK

(3)

No. 01-0035

In The

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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27 pp

QUESTIONS PRESENTED

1. Did the Federal Circuit correctly interpret the claim element "module" to be a "housing," using the language in Claim 1 and the specification and drawings?

2. Under this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Co.*, 520 U.S. 17 (1997), does file wrapper estoppel arise when the patentee offers the Federal Circuit no explanation for a claim amendment?

3. Under the doctrine of claim differentiation, did the Federal Circuit properly construe an independent claim to not include an element contained in a dependent claim?

4. Under the doctrine of equivalent's corollary to the "all limitations" rule, did the Federal Circuit correctly conclude that Claim 1 does not embrace a "sensing means" outside of the housing or module in which the receiving circuit is located?

CORPORATE DISCLOSURE STATEMENT

R.F. Technologies, Inc. has no parent corporation and has issued no shares to the public.

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STATEMENT OF THE CASE

This case involves the construction of Claim 1 of U.S. Patent No. 4,682,155 (the " '155 Patent") owned by Petitioner, Senior Technologies, Inc. The '155 Patent covers a wanderer monitoring system that has a transmitter affixed to the limb of the monitored individual, a sensing module mounted adjacent to a monitored door, a door switch mounted on a monitored door, and an alarm. (Joint Appendix before the Federal Circuit, A000084, Col. 8:57-68.)

Claim 1 recites the components of the security sensing system to include "a sensing module for installing adjacent" to a monitored door. (Joint Appendix before the Federal Circuit, A000084, Col. 8:61-62.) The sensing module responds to the signals from the transmitter and produces an output response which in turn energizes an alarm, when the monitored door is open. (Joint Appendix before the Federal Circuit, A000084, Col. 8:63-68.) The sensing module is defined as "including a receiving circuit and associated sensing means," all of which are adjacent to the monitored door. (Joint Appendix before the Federal Circuit, A000085, Col. 9:5-7). Claim 1 specifies that the receiving circuit is inside the sensing module. (Joint Appendix before the Federal Circuit, A000085, Col. 9:9-10.)

Petitioner originally accused eighteen (18) systems of infringing all 18 claims of the '155 Patent, as well as claims in another patent owned by Petitioner which was not the subject of the appeal to the Federal Circuit, and is not the subject of the Petition for Certiorari. (Appendix C, p. 30, footnote 3.) At the close of Plaintiff's case, the

district court dismissed the infringement claims against fourteen of the eighteen accused systems due to Petitioner's failure to offer sufficient evidence concerning the operation of these accused devices and how these devices allegedly infringed the patents at issue. (Appendix C, p. 30, footnote 3.) At the conclusion of the trial, the court found the four remaining accused devices did not infringe any of the claims of the '155 Patent or the other patent owned by Petitioner. (Appendix C, pp. 30, 52, ¶ 18; pp. 56-57, ¶ 28.)

The district court found that Claim 1 disclosed a "sensing module" with a receiving circuit inside that responded to the signals from the transmitter and produced a response. (Appendix C, pp. 31-32, ¶ 6.) Claim 1 required the sensing module to be mounted adjacent to the monitored door. *Id.* The district court also found that the sensing module mounted adjacent to the door included the "sensing means" or antenna. (Appendix C, pp. 48-49, ¶¶ 11-12.) The district court found that the accused products did not have **both** the claimed receiving circuit and associated sensing means in the sensing module located adjacent to the door and therefore they did not infringe Claim 1. (Appendix C, p. 52, ¶ 18.) This difference was one of three bases on which the district court found the four accused devices did not infringe Claim 1. (Appendix C, p. 52, ¶ 18.) The district court also concluded that the accused devices did not have the "receiving circuit" disclosed in Claim 1 and the accused devices were always enabled, whereas the receiving circuit in the '155 Patent was disabled until the door switch ("means to enable") enabled the receiving circuit. (Appendix C, p. 52, ¶¶ 18, 20; pp. 56-57, ¶ 28.)

Petitioner appealed some but not all issues relating to four claims (1, 2, 6 and 8) of the '155 Patent. Petitioner **did not** appeal the district court's construction of the "sensing module" in Claim 1 and specifically did not appeal the district court's conclusion that the receiving circuit **and** "sensing means" or antenna are in a single sensing module, which must be located adjacent to the monitored door. Instead, Petitioner appealed the construction of Claim 6 which was not the subject of Petitioner's subsequent Petition for Rehearing to the Federal Circuit and is not the subject of the Petition for Certiorari. (Appellants Brief before the Federal Circuit, pp. 50-52.)

Petitioner's only argument on appeal to the Federal Circuit relating to the sensing module in Claim 1 was challenging the district court's *factual conclusion* that the receiving circuit and sensing module *in the accused devices* are not all located adjacent to the monitored door. Petitioner argued they **could** be located adjacent to the door and it was error for the district court to find to the contrary. (Appellant's Brief before the Federal Circuit, pp. 51-52.)

Petitioner's principal focus on appeal was the district court's conclusion that the accused products did not have the disclosed receiving circuit and that the disclosed receiving circuit was disabled until the door switch ("means to enable") enabled the receiving circuit, unlike the accused devices, which were always enabled. (Appellant's Brief before the Federal Circuit, pp. 22-50, 53-59.)

The Federal Circuit agreed the receiving circuit in Claim 6 was disabled until enabled, disagreed that the receiving circuit in Claim 1 was disabled until enabled

and concluded the district court erred in its comparison of the accused products' receiving circuit to the disclosed receiving circuit. (Appendix A, pp. 7-8, 9-10, 19.) Petitioner incorrectly states that the Federal Circuit found the district court's finding of non-infringement was clear error. The Federal Circuit held the district court's conclusions that the accused products did not have the disclosed receiving circuit was clear error. (Appendix A, p. 9.) The Federal Circuit **affirmed** the district court's finding of non-infringement based on its construction of the sensing module, which was consistent with the district court's construction. (Appendix A, pp. 12-13, 14, 16.) While Petitioner sought rehearing on the Federal Circuit's construction of the "sensing module" in Claim 1, Petitioner **never** challenged the district court's construction of the "sensing module" in its original appeal to the Federal Circuit. (Appellant's Brief before the Federal Circuit, pp. 50-52.)

Key to the Federal Circuit's infringement analysis was the composition and location of the "sensing module," the device that receives signals from a transmitter, and produces an output response to energize an alarm. The Federal Circuit concluded that the patent required the "sensing means" or antenna (the device that receives the signal from the transmitter) and the receiving circuit (the device that produces an output response to energize an alarm) be part of the sensing module, which must be located adjacent to a monitored door. (Appendix A, pp. 10-11, 13, 14.)

Four accused devices are the subject of the Petition for Certiorari. (Appendix A, p. 5.) Three devices (the CA 9100, 9120 and 600) do not have the receiving circuit (as

construed by the Federal Circuit) in a single sensing module located adjacent to the door. (Appendix A, p. 13.) Rather, only part of the receiving circuit is included in a module located adjacent to the door. (Appendix A, p. 13.) The other part is in another unit, a control unit, mounted at a different and arbitrary location. (Appendix A, p. 13.) The fourth device (the CA 9000) does not have a "sensing means" or antenna and receiving circuit in a single unit mounted adjacent to the monitored door. (Appendix A, p. 16.) Only the antenna is mounted near the door. The entire receiving circuit is in a different unit at another location. (Appendix A, p. 16.)

Contrary to Petitioner's assertion, the Federal Circuit did not rely on Claim 6 to construe the "sensing module" to be a "housing." Rather, based on the language in Claim 1, as reinforced by the specification, the Federal Circuit concluded the "sensing module" was a single unit in which the receiving circuit and "sensing means" or antenna were located, and the single unit was mounted adjacent to the door. (Appendix A, p. 15.) The Federal Circuit used the term "housing" to describe the module. The Federal Circuit concluded that the accused devices do not have a single unit mounted adjacent to the door which include both the receiving circuit and sensing means and, therefore, they do not infringe Claim 1. (Appendix A, pp. 10-11.)

Specifically, the Federal Circuit concluded that three devices (the CA 9100, 9120 and 600) do not have the entire receiving circuit in the sensing module located adjacent to the door. (Appendix A, p. 13.) Therefore, they do not literally infringe.

Likewise, the CA 9000 only has a "sensing means" or antenna adjacent to the door. *Id.* The receiving circuit is located at another arbitrary location. Applying the doctrine of claim differentiation, the Federal Circuit concluded that the "sensing module" in Claim 1 could not be expanded to include a device that had one unit containing the receiving circuit and another unit containing the "sensing means." (Appendix A, p. 15.) The court reached this conclusion by comparing Claim 1 to Claim 4, a dependent claim to Claim 1, and finding that Claim 4 defines the invention as having a sensing module adjacent to the door, but only including the receiving circuit. (Appendix A, pp. 14-15.) The "sensing means," or antenna, is in another unit mounted over double doors. (Appendix A, p. 15.) Applying the doctrine of claim differentiation, the Federal Circuit concluded to construe Claim 1 to allow the sensing means to be located in a unit other than in the sensing module would render Claim 4 superfluous. (Appendix A, p. 15.) Therefore, the Federal Circuit concluded the CA 9000 did not literally infringe Claim 1. (Appendix A, p. 16.)

The Federal Circuit also analyzed all four units under the doctrine of equivalents. As to three devices (the CA 9100, 9120, and 600), the Federal Circuit concluded there was no infringement under the doctrine of equivalents because the definition of "sensing module" in Claim 1 was amended to overcome a rejection based on indefiniteness and the amendment specifically recited that the receiving circuit was in the sensing module. (Appendix A, pp. 13-14.) Petitioner never offered any alternative explanation for this amendment and the Federal Circuit

concluded prosecution history estoppel applied. (Appendix A, p. 14.) Therefore, the devices (the CA 9100, 9120 and 600) in which only part of the receiving circuit (as defined by the Federal Circuit) was in the sensing module adjacent to the door did not have an element equivalent to the claimed sensing module. *Id.*

Relying on the doctrine of equivalent's corollary to the "all limitations" rule, the Federal Circuit concluded Claim 1 did not disclose a device with an antenna located in a separate unit. Since the concept of equivalency did not embrace this structure, but rather it was specifically excluded from the scope of the claim, the claim could not be expanded under the doctrine of equivalents. (Appendix A, pp. 16-17.) Therefore, the CA 9000, which has an antenna in one unit and a receiving circuit in another unit did not infringe Claim 1 under the doctrine of equivalents. (Appendix A, pp. 16-17.) The Federal Circuit relied on its decision in *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996) to reach this conclusion.

SUMMARY OF ARGUMENT

This case does not warrant review. Petitioner argues the decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381 (Fed. Cir. 1999) was improperly applied and that the Federal Circuit improperly imported a claim limitation into Claim 1, thereby creating confusion among patentees and the public concerning the construction of claims and the effect claim amendments have on the breadth of a claim. Petitioner raises these

issues with the hopes of "tagging along" on this Court's recent grant of certiorari in *Festo*.

However, as will be demonstrated below, whatever this Court decides in *Festo* will have no impact on the Federal Circuit's decision in this case. Further, the Federal Circuit's decision does not conflict with the law of any case decided by this Court or the Federal Circuit regarding claim construction. Rather, Petitioner's complaint essentially boils down to alleged errors in the construction of the "sensing module" and "sensing means" in Claim 1 of the '155 Patent and alleged factual errors concerning the reason for the amendment to the meaning of "sensing module." Yet, Petitioner never argued in its appeal to the Federal Circuit that the district court's construction of these elements was erroneous. Further, the Petitioner never offered to the Federal Circuit any explanation for the amendment. Therefore, Petitioner waived any rights to challenge that construction and the Federal Circuit's affirmance of that construction. Petitioner also waived any right to challenge the Federal Circuit's conclusion that the amendment related to patentability.

The construction of "sensing module" as being a compact unit that includes both the receiving circuit and "sensing means" or antenna is consistent with the claim language and the specification. Use of the word "housing" to describe the module is consistent with the specification and imports no limitation not already in the claim. Likewise, the Federal Circuit's findings concerning the "sensing means" do not conflict with any decision of this Court or the Federal Circuit. Based on the doctrine of claim differentiation, the Federal Circuit concluded the

Claim 1 "sensing means" did not encompass a sensing means outside of the unit with the receiving circuit. Therefore, the CA 9000 did not literally infringe Claim 1. Based on the doctrine of equivalents' corollary to the "all limitations" rule, the Federal Circuit further concluded that the language in Claim 1 describing the "sensing means" as being included in the sensing module with the receiving circuit, precluded an expansion of that element to cover a sensing means outside of that unit. Therefore, the CA 9000 did not infringe under the doctrine of equivalents.

Further, the amendment directly affected the meaning of the element "sensing module." Since Petitioner never offered to the Federal Circuit any explanation for the amendment made to this element, under this Court's decision in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 137 L.Ed.2d 146, 117 S.Ct. 1040 (1997), the Federal Circuit's application of prosecution history estoppel was appropriate. The fact the Federal Circuit cited to *Festo* as support for this conclusion does not give rise to grounds for review, since the Federal Circuit's decision is mandated by *Warner-Jenkinson*.

Finally, contrary to Petitioner's argument, nothing in the Federal Circuit's decision makes it difficult to know the scope of claims. The Federal Circuit applied the law consistent with federal precedent. Petitioner simply disagrees with the findings and conclusions. Yet Petitioner could have sought relief by raising these issues in its original appeal. Having failed to do so, Petitioner cannot ask this Court to provide that remedy.

REASONS FOR DENYING PETITION

A. Petitioner Waived Its Complaint Concerning The Construction Of "Sensing Module" In Claim 1 By Failing To Claim Error In Its Appeal.

Petitioner asserts the Federal Circuit improperly imported an element – namely, a "housing" – into Claim 1 in contravention of this Court's decision in *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895), and the Federal Circuit's decision in *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998). In *McCarty*, the lower court's dismissal of an infringement case based on its conclusion the patent was anticipated by prior devices was under review. This Court declined to "read in" features from the specification and drawings to avoid the defense of anticipation and sustain the patent. In *Renishaw*, the Federal Circuit reiterated two canons of claim construction: (a) one may not read a limitation into a claim from the written description; but (b) one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part. *Id.* at 1248. The latter is precisely what the Federal Circuit did, which is consistent with *McCarty* and *Renishaw*. Therefore, the Federal Circuit did not introduce a new criteria for construing a claim.

Petitioner quarrels with the Federal Circuit's construction that the receiving circuit and sensing means (i.e., antenna) are in a "sensing module housing" located adjacent to the door. While Claim 1 does not recite a "sensing module housing," it does recite a "sensing module" that includes a "sensing means" (or antenna) and a

receiving circuit, all of which are located adjacent to the mounted door. While the district court did not use the term "housing" to describe the sensing module that contains the sensing means (or antenna) and the receiving circuit, it reached the same conclusion; namely, these two components are in one unit located adjacent to the monitored door. Based on this construction, the district court found the accused devices did not have both components in a unit adjacent to the monitored door and therefore did not infringe. Petitioner never challenged this construction on appeal and has now waived any right to do so. *See Grupo Mexicano v. Alliance Bond Fund*, 527 U.S. 308, 144 L.Ed.2d 319, 330 n.3, 119 S.Ct. 1961 (1999); *Campbell v. Louisiana*, 523 U.S. 392, 140 L.Ed.2d 551, 562, 118 S.Ct. 1419 (1998); *Pennsylvania Dept. of Corrections v. Yeskey*, 524 U.S. 206, 141 L.Ed.2d 215, 221, 118 S.Ct. 1952 (1998); *Auer v. Robbins*, 519 U.S. 452, 137 L.Ed.2d 79, 92, 117 S.Ct. 905 (1997); *United States v. Alvarez-Sanchez*, 511 U.S. 350, 114 S.Ct. 1599, 128 L.Ed.2d 319 (1994); *Montana Dept. of Rev. v. Kurth Ranch*, 511 U.S. 767, 128 L.Ed.2d 767, 774 n.9, 114 S.Ct. 1937 (1994).

B. The Federal Circuit's Construction Of "Sensing Module" Is Supported By The Claim Language And Specifications

Quite apart from Petitioner's waiver of this claimed error, the Federal Circuit's construction is consistent with the claim language and specifications and drawing as well as the claim construction canons under *Renishaw*. While the Federal Circuit used the term "housing" to describe the composite unit located adjacent to the door, use of the word does not constitute the addition of a

claim element in violation of *McCarty* or *Renishaw*. Whether these components are in a housing or not is not relevant. They are in the "sensing module" which is located adjacent to the door.

According to *Webster's New Universal Unabridged Dictionary*, Deluxe Second Edition, (1983), the word "module" is defined as follows: "In electronics, a compact assembly functioning as a component of a larger unit." Because the module is a compact unit, these components must be located adjacent to the monitored door, whether they are in a housing or not. The common meaning of the word "module" excludes a device where one part of the receiving circuit is located adjacent to the door and the other part is located at some other arbitrary location. That is the conclusion the Federal Circuit reached and it is amply supported by the claim language and the specification.

In fact, the Petitioner admits as much at p. 26 of the Petition for Certiorari where Petitioner argues "modules" are "components gathered together to perform a function." This definition advanced by Petitioner is consistent with a module being a compact unit and is totally *inconsistent* with Petitioner's newly advanced argument that the components can be spread over a large geographic area.

Further, contrary to Petitioner's argument, the specification does not clearly distinguish the physical sensing module from a sensing module housing. At Column 8, lines 8-13 of the '155 Patent, the passage relied on by the Federal Circuit to assist in the construction of "sensing

module," the patentee states: "[t]he switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiver circuit 14 is located. The housing 174 has an output cable 176 which connects it to a remote nursing station where the alarm or buzzer is located and it also has a connection to a source of power." (Joint Appendix before the Federal Circuit, A000084, Col. 8:8-13.) If the housing referred to in these lines of the patent were distinct from the physical sensing module, the system would not function. Use of the word "housing" in Col. 8, ll. 8-13 makes "housing" synonymous with "module," and it is in that sense that the Federal Circuit used "housing." Further, this section of the patent is describing Figure 5, the depiction of the system for a single monitored door, the very subject of Claim 1.

Contrary to Petitioner's argument, the sensing module housing *does* play a role in the reception of the radio signal *and* its application, because it is the sensing module housing to which the switch 168 is connected by leads 170-172, which has the receiver circuit 14 within it, which has an output cable 176 which connects it to a remote nursing station where the alarm or buzzer is located, and which also has a connection to a source of power. This description by the patentee makes the sensing module housing a functioning part of the system. The kind of housing to which Petitioner refers would not be connected by leads to a switch, would not have an output cable that connects it to a nursing station and would not be connected to a source of power.

There is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification. *Comark*

Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186-7 (Fed. Cir. 1998), citing 1 Donald S. Chisum, *Chisum on Patents*, § 3.02[1] and n.12 (rel. Dec. 1996) ("The line between interpreting claim language in light of the specification and reading a limitation from the specification into the claim is a fine one.") Clearly, the Federal Circuit's analysis is completely consistent with *Renishaw* and *McCarty*.

Petitioner's first question does not raise any conflict with the decisions of this Court or those of the Federal Circuit which warrants review.

C. The Federal Circuit's Conclusions Regarding The Doctrine Of Equivalents Is Consistent With And Mandated By This Court's Decision In *Warner-Jenkinson*

Petitioner argues the amendment to Claim 1 specifying that the receiving circuit is in the sensing module was not an amendment relating to patentability and therefore it was improper for the Federal Circuit to apply prosecution history estoppel to this claim element and preclude infringement under the doctrine of equivalents. Petitioner argues the additional language only reiterates what already was contained in the fourth paragraph of the original Claim 1 by virtue of the language "sensing module including receiving circuit and associated sensing means." Petitioner characterizes the modification to paragraph 5 of Claim 1 as an "editorial" change. Petitioner argues the Federal Circuit's conclusion raises the concern that corrections of mere grammatical mistakes or of a

trivial nature could give rise to prosecution history estoppel. That simply is not the case.

Petitioner never offered to the Federal Circuit this explanation or any other explanation for this amendment. Therefore, under *Warner-Jenkinson*, the amendment is presumed to have been made for patentability reasons. As this Court said in *Warner-Jenkinson*:

> . . . [w]e think the better rule is to place the burden on the patent holder to establish the reason for the amendment required during patent prosecution. . . . Where no explanation is established, however, the court should presume that the patent applicant had a substantial reason related to patentability for including the limiting element added by a amendment. In those circumstances, prosecution history estoppel would bar the application of the doctrine of equivalents to that element. 520 U.S. at 33.

Clearly, the Federal Circuit's decision is consistent with this Court's decision and, therefore, presents no conflict in federal law for this Court to resolve.

Further, Petitioner's belated explanation is not supported by the record before the PTO or the common and ordinary meaning of the language at issue. Petitioner essentially argues the language "sensing module including a receiving circuit" is the same as "receiving circuit in the sensing module." Based on the ordinary and common meaning of the language, that is not true. "[S]ensing module including a receiving circuit" refers to "a" or "one" receiving circuit without indicating there is no other receiving circuit in the system. The original Claim 1 had an ambiguity as to whether the receiving circuit

mentioned in the last element was the same receiving circuit or a different one. Consequently, the receiving circuit mentioned in the last paragraph of the originally drafted Claim 1 was indefinite. A common way of resolving such a difficulty is to identify the receiving circuit mentioned in the last element as "said receiving circuit." The patentee did not do that in the original version of Claim 1, giving rise to the ambiguity. The insertion of the phrase "the sensing module" in the last paragraph of Claim 1 was intended to overcome indefiniteness by narrowing the identification of the receiving circuit mentioned in the last paragraph of the claim from an arbitrary receiving circuit to the specific receiving circuit mentioned in the fourth paragraph of the claim. Therefore, it was not a mere editorial change, but a change relating to patentability.

Petitioner admits as much at p. 21 of the Petition where Petitioner states the amendment was made for "clarity." Further, counsel for the patentee in his response to the rejection characterized the amendment to Claim 1 as clarifying ambiguities. (Joint Appendix before the Federal Circuit A001519.)

D. The Federal Circuit's Conclusions Regarding The "Sensing Means" Based On Claim Differentiation And The "All Limitations" Rule Does Not Warrant Review

Petitioner also quarrels with the conclusion that the "sensing means" or antenna is located in the sensing module. However, Petitioner never claimed error in this construction in its original appeal. Instead, the Petitioner

argued the "sensing means" or antenna and the receiving circuit in the accused devices *could* all be located adjacent to the door and therefore the devices did infringe Claim 1. Having failed to challenge the district court's construction of "sensing means" in their original appeal to the Federal Circuit, Petitioner waived any right to raise this argument now. *See* citations at p. 11, *supra*. Further, Petitioner cannot now advance a construction of Claim 1 contrary to the position taken on appeal. *See Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997) (court refused to consider patentee's new theory of claim construction noting that with rare exception appellate courts do not consider a party's new theories lodged first on appeal).

Petitioner makes three additional arguments of error, none of which warrant review by this Court.

First, Petitioner argues that the word "associated" in the claim language "the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored" permits the "sensing means" to be outside of the sensing module which contains the receiving circuit. Petitioner argues, without citation to authority, that "associated with" means "connected with," not "part of." Based on this "definition," Petitioner suggests that in Claim 1 the sensing module includes the receiving circuit but not the associated sensing means and that the receiving circuit is located adjacent to the door opening but the associated sensing means is not. That construction conflicts with the clear meaning of the language "and associated sensing means located adjacent to the door opening to be monitored." (Joint Appendix before the Federal Circuit,

A000085, Col. 9:5-7.) The claim language clearly states the sensing means is located adjacent to the door. The specification explains that for the system to work the "sensing means" or antenna must be adjacent to the door. (Joint Appendix before the Federal Circuit, A000082-83, Col. 3:49-55, Col. 4:1-4, 35-39, Col. 5:61-65.) Further, the use of the word "associated" after "receiver" and before "sensing means" clearly means both components are adjacent to the door. The common and ordinary meaning of "associated" is "to join (things) together or connect (one thing) with another" and "to combine or join with another or others, as component parts." *Webster's Third New International Dictionary Unabridged* at 132 (1981). Based on the common and ordinary meaning of the claim language as corroborated by the specification, the construction by the district court and Federal Circuit is correct.

Second, Petitioner argues that contrary to the Federal Circuit's construction, Claim 4 supports a construction that the "sensing means" may be outside of the sensing module. Again, Petitioner failed to make this argument in its original appeal to the Federal Circuit. Therefore, Petitioner waived this claim of error. Nonetheless, Claim 4 clearly refers to an embodiment of the invention different from the embodiment referred to in Claim 1. In the embodiment referred to in Claim 4, there are two door members and an elongated sensing member extending transversely across at least one of the door members. Under the doctrine of claim differentiation, the embodiment referred to in Claim 1 cannot have two door members and an elongated sensing member transversely across at least one of its door members. The specific language in Claim 1 refers to "a door" or "the door."

(Joint Appendix before the Federal Circuit, A000084-85, Col. 8:58, 62, 63, Col. 9:6-7, 8.) Furthermore, the sensing module in Claim 4 cannot be "located adjacent to the door opening" as required in Claim 1 and yet include "an elongated sensing member extending transversely across at least one of the door members *in* the door opening" as claimed in Claim 4.

Under the doctrine of claim differentiation:

> There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant.

Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed. Cir. 1998) (quoting *Tandon Corp. v. United States International Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987)). Further, the doctrine normally means that limitations stated in dependent claims are not to be read into the independent claim from which they depend. *Karlin Technology Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-2 (Fed. Cir. 1999). In short, the doctrine of claim differentiation supports the Federal Circuit's constructions.

Finally, Petitioner quarrels with the Federal Circuit's conclusion that under the doctrine of equivalents, Claim 1 does not encompass devices that have the antenna outside of the sensing module. Petitioner mischaracterizes the analysis as implicating *Festo* to enhance the

chances of its Petition being granted. However, the Federal Circuit did not base its conclusion of non-infringement on *Festo*. Rather the Federal Circuit relied on the doctrine of equivalent's corollary to the "all limitations" rule. Specifically, relying on *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996), the Federal Circuit concluded that once the claim specifies the antenna is in the sensing module, the claim cannot encompass an antenna outside of the sensing module. (Appendix A, p. 16.) As the Federal Circuit in *Athletic Alternatives* explained "the concept of equivalency cannot embrace a structure that is specifically excluded from the scope of claims." *Athletic Alternatives*, 73 F.3d at 1582, citing *Dolly, Inc. v. Spalding J. Evenflo Companies, Inc.*, 16 F.3d 394, 400 (Fed. Cir. 1994). This conclusion is wholly consistent with the well-established tenet that the doctrine of equivalents cannot expand or enlarge the scope of the claims. *Dolly*, 16 F.3d at 398.

Since the court did not reach its decision based on *Festo*, this issue will not be affected by this Court's decision in *Festo* and this question does not warrant review.

CONCLUSION

In sum, the Petitioner does not raise any novel or momentous issues warranting review by this Court. Rather, the Federal Circuit's decision is consistent with and mandated by well-established precedent quite independent of the Court's pending review of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381 (Fed.

Cir. 1999). For these reasons, the Petition for Certiorari should be denied.

Respectfully submitted,

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No. 01-35

IN THE

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ of Certiorari
To The U.S. Court of Appeals for the Federal Circuit

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION

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Petitioner's Corporate Disclosure Statement:

> Senior Technologies, Inc. has no parent company and has issued no shares to the public.

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NEW POINTS PRESENTED IN BRIEF IN OPPOSITION

The Respondent's brief in opposition rewords the three questions presented to the Court in the Petitioner's petition into four questions with entirely different meaning. The first question presented by the Petitioner is related to the propriety of construing claim 1 to include a limitation of a "housing", namely:

> "1. Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?"
>
> (Petition for Writ of Certiorari, page i)

The second and third questions presented in the Petitioner's petition for writ of certiorari relate to the application of the doctrine of equivalents, namely:

> "2. Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999)?
>
> 3. May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be

> expanded under the doctrine of equivalents?"
>
> (Petition for Writ of Certiorari, page i).

The four new or reworded questions proposed by the Respondent include three questions related to construing a claim to contain an element not directly recited, questions 1, 3 and 4, and one question related to the doctrine of equivalents, question 2.

Questions 1, 3 and 4 in the Respondent's brief are:

> "1. Did the Federal Circuit correctly interpret the claim element "module" to be a "housing," using the language in Claim 1 and the specification and drawings?
>
> 3. Under the doctrine of claim differentiation, did the Federal Circuit properly construe an independent claim to not include an element contained in a dependent claim?
>
> 4. Under the doctrine of equivalent's corollary to the "all limitations" rule, did the Federal Circuit correctly conclude that Claim 1 does not embrace a "sensing means" outside of the housing or module in which the receiving circuit is located?"
>
> (Respondent's Brief in Opposition, page i)

Firstly, the fourth question is properly a limitation on the manner of applying the doctrine of equivalents and isn't applicable to the question in this case of whether the limitations construed by the Court to be in claim 1 are properly considered in claim 1. The third question also seems misplaced since it does not address the limitations in question, namely, is claim 1 limited by a single housing within which lies the receiving circuit which is the limitation the Court of Appeals for the Federal Circuit construed to be in claim 1 when it held:

> "We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us.....
>
> Another issue before the district court was whether the '155 patent disclosed a limitation of a single housing within which lies the receiving circuit. As a matter of law, we conclude that both claims 1 and 6 do include such a limitation."
>
> (Appendix A, page 10, beginning with the second paragraph)

The Court of Appeals clearly did construe a single housing in which lies the receiving circuit into claim 1, although it is not recited.

The Petitioner's position is still correct because neither the doctrine of claim differentiation nor the "all

limitations" rule authorize the construction of an element from the specification into a claim.

The second question in the Respondent's brief is:

> "2. Under this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Co.*, 520 U.S. 17 (1997), does file wrapper estoppel arise when the patentee offers the Federal Circuit no explanation for a claim amendment?"
>
> (Respondent's Brief in Opposition, page i)

This question seems inappropriate since the Court of Appeals in its new ground for affirming the decision below does not rely on file wrapper estoppel, but the Court of Appeals expressly recognized that a reason was given for the amendment to claim 1.

The Court of Appeals for the Federal Circuit states in its decision of March 12, 2001:

> "Furthermore, the prosecution history reveals that, in order "to clarify ambiguities," claim 1 was amended such that "the receiving circuit" would be specifically located "in the sensing module." Hence, the claim language, specification, and prosecution history all indicate that the receiving circuit must be contained within the housing of the sensing module."
>
> (Appendix A, page 11, lines 10-17)

There is no discussion in this section of whether the amendment related to patentability or not. The ambiguity related to a slight difference in the language of a similar recitation earlier in the original claim filed before the United States Patent and Trademark Office and a second related recitation.

The *Warner-Jenkinson* case does not require the explanation for an amendment to be in a brief on appeal but requires it to be established by the applicant. This was done in the file wrapper history with the amendment that it explains. That condition is satisfied here as pointed out by the Court of Appeals for the Federal Circuit. The amendment was made to cure ambiguities (Appendix A, page 11, lines 10-17). The nature of those ambiguities are clear from the claim and the arguments in the amendment.

The District Court referred to that quotation as did the Court of Appeals for the Federal Circuit but only the District Court held there was file wrapper estoppel because of it. The District Court held file wrapper estoppel under *Festo (supra)* and *Athletic (supra)* under which decisions it made no difference what reasons were given in the file wrapper (Appendix A, page 13, last paragraph, to page 14, first paragraph, and page 16, second paragraph). The ambiguity in the file wrapper was a slight deviation in the language in which the location of the sensing module was described in two places. It was not made in response to a prior art rejection and raised no issue of substance.

The ambiguity was cured by using the same language in both places without changing any meaning or adding any limitation. The original claim as

submitted included the limitation "sensing module including a receiving circuit" in the fourth paragraph but in the fifth paragraph it was recited as "receiving circuit" (Joint Appendix before Court of Appeals, page A001362). The amendment was to change the recitation in the fifth paragraph from "response to the opening of the door" to "means to enable the receiving circuit in the sensing module" rather than merely the receiving circuit and thus made it correspond to the recitation in the fourth paragraph stating that the sensing module includes the receiving circuit (Joint Appendix before Court of Appeals, page A001382). This was clearly not a matter of substance but the curing of an ambiguity and was argued as such (Joint Appendix before Court of Appeals, page A001384).

The position of the Court of Appeals for the Federal Circuit was that it was an amendment and it was unnecessary to look further because of the holding that the doctrine of equivalents can not be applied under *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996) and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999).

In addition to rewording the questions, the Respondent's brief in opposition presents two new points discussed below.

1. Did the Court of Appeals reverse the District Court's decision of noninfringement but find alternative grounds for affirming, which alternative grounds are the subject of this petition (Respondent's Brief in Opposition, page 4, lines 6-12)?

The Court of Appeals for the Federal Circuit addressed what it characterized as the main issue of the Appellant (Appendix A, page 8, first full paragraph). The question of the interpretation of claim 1 was considered and whether there was error on the part of the Court of Appeals for the Federal Circuit in reading language from the specification into the claim. The Appellant's position in its brief on appeal is that without such an improper reading of a limitation into claim 1, there would be literal infringement (Appellant's Brief of January 21, 2000, Statement of Issues (b) and (d), page 3).

It appears that the Court of Appeals for the Federal Circuit agreed with the Appellant that there would be literal infringement. The Court of Appeals for the Federal Circuit in rendering its decision stated:

> "Therefore, the district court erred by not including the microprocessor in its comparison of the accused device with the construed "receiving circuit." When the functions of the microprocessor are properly understood, and the claim is read on those functions, the presence of the microprocessor in the accused device provides no ground for noninfringement of the claims.
>
> We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us."
>
> (Appendix A, page 9, last line, through page 10, line 10).

Clearly the Court believed that its reversal of the interpretation of the accused device resulted in infringement. Why else would it refer to alternative grounds and continue its following discussion without affirming a specific holding of the District Court. Instead, it re-analyzed the claims, clearly stating "Having properly construed claims 1 and 6 to require a single housing within which lies a receiving circuit..." (Appendix A, page 13, lines 3-4). In making its holding, the Court states "Moreover, the same passage from the specification mentioned above confirms this interpretation in that the "switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiv[ing] circuit is located." (Appendix A, page 11, lines 23-26).

Petitioner's position is that the mere holding that the receiving circuit must be in the sensing module would not preclude infringement since the word "module" does not by itself necessarily imply anything about how closely together the components of the module must be packed but instead is a functional term as shown by the manner in which it is used in the claim, e.g. transmitting module and sensing module.

Claim 1 not only does not recite "housing", it doesn't recite the sensing module and receiving means in a single housing. It does not recite anything about the location of the components of the sensing module but only what at least some of those components are.

2. Has the Petitioner waived its right to argue error in applying *Festo (supra)* and *Athletic (supra)* in

the Court of Appeals' alternative grounds for affirming the court below (Respondent's Brief in Opposition, page 8, lines 13-19)?

It was unnecessary to avoid a waiver for the Petitioner to more specifically argue the interpretation of the claims other than to point out, as it did, that limitations were improperly read into the claims. Its position was there was literal infringement of claim 1.

The alternative grounds for affirming the court below, by interpreting claim 1 as including a housing in which the sensing module and the receiving circuit were located, raises the question of file wrapper estoppel.

It is the Petitioner's position that the Court of Appeals improperly construed claim 1 to include limitations not recited in it to affirm the District Court's holding of no literal infringement and then to rely upon *Festo (supra)* and *Athletic (supra)* to preclude infringement under the doctrine of equivalents.

CONCLUSION

The three questions presented by the Petitioner are significant matters of concern to the businesses that wish to produce new products because these questions relate to the decisions made by manufacturers concerning what they are entitled to manufacture and what is covered by another's patent rights and on the other hand, whether the rights available to an inventor under the patent system are worth the cost of development. A decision on the questions presented in

the Petitioner's petition will increase the certainty with which such questions can be answered.

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